127-361

TRANSCRIPT OF RECORD.

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1887.

No. 240.

GEORGE B. CORNELL, APPELLANT,

vs.

PAUL WEIDNER.

APPEAL FROM THE CIRCUIT COURT OF THE UNITED STATES FOR THE EASTERN DISTRICT OF MICHIGAN.

FILED JULY 2, 1885.

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JUDD & DETWEILER, PRINTERS, WASHINGTON, SEPTEMBER 15, 1887.

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1 *Bill of Complaint.*

United States Circuit Court, Eastern District of Michigan.

To the honorable the judges of the circuit court of the United States for the eastern district of Michigan, in chancery sitting:

George B. Cornell, of the city of Chicago, in the State of Illinois, and a citizen of said State, brings this his bill of complaint against Paul Weidner, of the city of Detroit, in the State of Michigan, and a citizen of said State.

And thereupon your orator complains and says that before the twenty-ninth day of August, eighteen hundred and seventy-one, John Lacey and George B. Cornell, your orators, were the true, original, and first inventors of certain new and useful improvements in metallic bushings for the bungs of casks, etc., and in wrenches for operating the same, not known or used by others before their said invention thereof, — been in public use or on sale with their consent or allowance for more than two years prior to their application for a patent therefor, as your orator verily believes.

And your orator further shows unto your honors that the said John Lacey and George B. Cornell, your orators, so being the inventors of said improvements and being citizens of the United States aforesaid, made application to the proper department of the Government of the United States for letters patent therefor in accordance with the then existing laws of Congress, and they having duly complied in all respects with the conditions and requisitions of said laws, such proceedings were had that on the twenty-ninth day of August, eighteen hundred and seventy-one, letters patent of the United States, No. 118,617, for the said improvements and inventions, under the seal of the Patent Office of the United States, signed by the Secretary of the Interior and countersigned by the Commissioner of Patents, and bearing date the day and year last aforesaid, were issued in due form of law and delivered to your orator, the said John Lacey having assigned all his right, title, and interest therein to your orator, whereby there was granted and secured to him and his heirs, executors, administrators, or assigns, for the term of seventeen years from the day of the date thereof, the full and exclusive right of making, using, and vending to others to be used, the said improvements and inventions, a description whereof is given in the words of the said inventors in a schedule in writing, accompanied by drawings and references thereto, duly annexed to said letters patent when the same were issued and made a part thereof, as by the said original letters patent, or a duly authenticated copy thereof, in court to be produced, will fully appear.

And your orator further shows unto your honors that afterwards, to wit, on the sixth day of August, 1872, your orator, said Lacey joining with him, for good and lawful cause, surrendered said last-mentioned letters patent to the Commissioner of Patents, and duly made application for new patents to be issued for the
2 same inventions, and accompanied such application with a corrected description and specification and with the requisite

drawings, and in all respects complied with the acts of Congress in such case made and provided; whereupon, on the sixth day of August, eighteen hundred and seventy-two, new letters patent in two divisions for the same inventions last mentioned were, in accordance with law, duly granted, issued, and delivered to your orator for the residue of said term of seventeen years; that said last-mentioned letters patent were severally issued in accordance with and in due form of law, under the seal of the Patent Office of the United States, signed by the Secretary of the Interior and countersigned by the Commissioner of Patents, and bear date the day and year last aforesaid, and were numbered and designated as reissue No. 5026, division A, and reissue No. 5027, division B, and that there was by said last-mentioned reissued letters patents secured to your orator, his heirs, executors, administrators, and assigns, for the term of seventeen years from the twenty-ninth day of August, eighteen hundred and seventy-one, the full and exclusive right of making, using, and vending to others to be used, said original improvements and inventions in metallic bushings for bungs of casks, etc., and in wrenches for operating the same; that a legal corrected description and specification of each of said original improvements and inventions contained in said reissued letters patent is given in the words of the said inventors in a certain schedule, accompanied by drawings and written references thereto, which was in due form of law annexed, respectively, to said reissued letters patent at the time the same were issued and made a part thereof, as by said last-mentioned reissued letters patent or duly authenticated copies thereof, to be produced as the court shall direct, will fully appear.

And your orator further shows unto your honors that afterwards, to wit, on the 17th day of June, 1879, your orator—said Lacey joining with him—for good and lawful cause, surrendered said last-mentioned reissue, 5025, letters patent to the Commissioner of Patents, and duly made application for a new patent to be issued for the same invention, and accompanied such application with a corrected description and specification and with the requisite drawings, and in all respects complied with the acts of Congress in such case made and provided; whereupon, on the seventeen day of June, eighteen hundred and seventy-nine, new letters patent for the same invention last mentioned were, in accordance with law, duly granted, issued, and delivered to your orator for the residue of said term of seventeen years; that said last-mentioned letters patent were issued in accordance with and in due form of law, under the seal of the Patent Office of the United States, signed by the acting Secretary of the Interior and countersigned by the Commissioner of Patents, and bear date the day and year last aforesaid, and were numbered and designated as reissue No. 8759; and that there was by said last-mentioned reissued letters patent secured to your orator, his heirs, executors, administrators, and assigns, for the term of seventeen years from the twenty-ninth day of August, eighteen hundred and seventy-one, the full and exclusive right of making, using, and vending to others to be used, said original improvement and invention in metallic bushings for the bungs of casks, etc.; that a legal

3 corrected description and specification of said original improvement and invention contained in said reissued letters patent is given in the words of the said inventors in a certain schedule accompanied by drawings and written references thereto, which was in due form of law annexed to said reissued letters patent at the time the same were issued and made a part thereof, as by the said last-mentioned reissued letters patent or a duly authenticated copy thereof, to be produced as the court shall direct, will fully appear.

Your orator further shows, on information and belief, not only that the form of bung bush described and claimed in said reissue 8759 was not known or used prior to the invention thereof by said Lacey and your orator, but that no form of metallic lining for bung-holes had been successfully reduced to practice, though the same has been repeatedly attempted, and that said Lacey and your orator not only invented said bush as described, but successfully reduced the same to practice, and your orator by his personal efforts and the efforts of those acting under him, has largely manufactured and brought the same into general use throughout the United States, and the same is the only bung bush in use, and is of great value to the public, and has remained in the exclusive possession of your orator and those holding under him, to the great benefit of the public, and great pecuniary gains have resulted and are still resulting to your orator from the said patent right and the manufacture and sale of bung bushes under the same.

Your orator further shows that said invention is designated, adapted, and used more especially for beer barrels or casks containing beer or other fermented liquor, and that your orator and said Lacey first applied and introduced said bung bushing into public use in the fall of 1869, having prior to that time spent much time, labor, and expense in experimenting with and adapting and perfecting said bung bushing for this use, and in devising a wrench by which said bushing might be applied to the cask as designated for use, and that since 1869 your orator has continuously manufactured and sold said bushings and wrenches and has supplied the same to nearly every brewer in the United States, and is now so engaged, and is and has been fully prepared to supply the great demand for the same.

Your orator further shows that Eilbert Schumaker and William Johnson in 1872 infringed said reissue 5026 by making and using a core wrench without the V projection specified in said patent with which to make the engagement of the wrench with the bush to screw in the bushes which did not have the notch in the flange, and for the doing of these things your orator, about December 9th, 1872, filed his bill of complaint in the United States circuit court for the eastern district of Wisconsin against said Schumaker & Johnson for an infringement of said reissue 5026, and they appeared and defended said suit, and set up that Chas. G. Stiefel, of St. Louis, Missouri, had publicly used substantially the same thing and applied metallic bung bushings to the bungs of barrels prior to any invention and application thereof by your orator and said Lacey, and setting up the defendant's own patent and the state of the art gen-

erally relating to bung bushes and wrenches; that issue was joined on all of said matters in said suit, and proofs were taken and said cause was brought to a hearing on or about the 25th of Feb-
4 ruary, 1874, and the proofs were then submitted and the cause argued before the Honorable Thomas Drummond, judge of said court, and taken under advisement by him until about March 7th, 1874, when he rendered his decision sustaining said patent and finding the defendants' said wrench to be an infringement, and referring said cause to the master in chancery of said court to ascertain the plaintiff's damages; that on said reference the number of such wrenches made by the defendants and the number of such bushes without the notch in the flange which had been inserted by them, the defendants, were shown, and on or about October 5th, 1874, said master made his report, showing $3,753.60 damages to the complainants, to which report the defendants filed exceptions and also filed a petition for a rehearing of said cause, which said exceptions and petition for rehearing were heard by the court on or about November 7th, 1874, and overruled, and said report was confirmed and a decree entered in said cause against the defendants for the amount of said damages and costs of suit, and the defendants were perpetually enjoined from making, using, or selling any more of such wrenches.

Your orator further shows that prior to the bringing of said suit against Schumaker & Johnson he had been advised by counsel learned in the law and was of the opinion and belief that his said reissued patents were entitled to a construction which would include the core wrench when used in connection with other means than the V projection described in the patent for making the connection with the bush to screw it in, and would include and cover the bush when made without the notch in the flange, and the court, on the hearing and trial of said cause, was of the same opinion.

Your orator further shows that George W. Gillett and the American Bung Bush Co., and also the Downer & Bemis Brewing Company, infringed said reissued patent in the northern district of Illinois by making, selling, and using bung wrenches with still another device than the V projection, and different from the one used by Schumaker & Johnson, and making, selling, and using bung bushes without the notch in the flange; and your orator brought a suit against said Gillett and the American Bung Bush Company and also against the said Downer & Bemis Brewing Company, during the year 1874, in the United States circuit court for the northern district of Illinois, on both of the said patents reissued—5026 and 5027—for said infringements, in which suits said Gillett and the American Bung Bush Company, the defendants in one, and the Downer & Bemis Brewing Company, the defendants in the other, appeared and answered and contended, among other things, that your orator's invention as set forth in said reissue 5027 was limited to the bush having the notch in the flange, and also contended that said bush was old and was known to and publicly used by Chas. G. Stiefel, of St. Louis, Missouri, prior to the invention thereof by your orator and said Lacey and more than two years before their application for letters patent

therefor, and that the same was shown in United States letters patent to Walter Calhoun, to D. F. Fetter, to Lichtenstandt and Pentlarge, to J. Ruegg, and to Kenyon and Menzies, all prior to the invention of your orator and said Lacey. On issue joined in said suits on all of said matters of defense proofs were taken and a hearing was had on the pleadings and proofs, at which able counsel appeared for the defendants and urged upon the court all of said matters of defense, and the court, upon consideration thereof, found for your orator in both of said causes and held that the bush made by the defendants having the notch omitted from the flange was an infringement upon said reissue No. 5027, as was contended for by your orator.

Your orator further shows that from the time of the decision in the circuit court in the Schumaker and Johnson case the public generally had acquiesced in the construction which was claimed for said reissue 5029 by your orator and his counsel and sustained by the court in said cause, to the effect that it covered the bush either with or without the notch in the flange down to winter of 1877–'8, during which time your orator continued to make and supply the demand for such bushes, and that his exclusive right in the premises was generally acquiesced in; but your orator shows that the said Schumaker & Johnson case was taken by appeal to the supreme court, and by them decided in the winter of 1877-'8, and by the dictum of their decision the supreme court indicated that the claim of said reissue 5027 covered only the bush having the notch in the flange, and that they would not sustain the view taken of said reissue by the circuit court, from which it appeared that the claim of said reissue was defective and insufficient to cover the real invention of your orator as therein shown, and your orator thereupon without delay surrendered said reissue 5027 and obtained this reissue, 8759, as hereinbefore stated.

Your orator further shows that in his application for said reissue 8759 the primary examiner in the Patent Office cited the following patents as each severally meeting the claim: United States patent to C. C. Stremme, No. 76779, of April 14, 1868; to Walter Calhoun, No. 85908, of January 19, 1869; to Lichtenstadt & Pentlarge, No. 202,285, of April 16, 1870; to Kenyon & Menzies, No. 38830, of June 19, 1863; to Summerfield, No. 47877, of May 23, 1866; to D. F. Fetter, No. 62189, of February 19, 1864, and to D. F. Fetter, No. 91618, of June 22, 1869; and English patent to Thompson, No. 1878, of 1863, and to Taylor, No. 1955, of 1864; upon which the examiner rejected the claim and application, and required the claim to be narrowed and restricted. He also rejected the claim for the bush with a notch in the flange because there was found in the Patent Office the patent of J. Miller, No. 63076, of March 19, 1867, showing a bush with two notches in the flange; but your orator finally took an appeal from said examiner on the claim as it now appears in said reissue 8759 to the board of examiners-in-chief of the Patent Office, and said board, upon an examination of all said matters, reversed the action of the primary examiner and allowed said application and claim.

Your orator further shows that the novelty and originality of the said invention and the validity of said reissue 8759 have been contested in the United States circuit court for the northern district of Illinois and sustained; that subsequent to the date of said reissue 8759 Crane Brothers Manufacturing Company of Chicago infringed upon the same by making and selling bung bushes the same as the bung bushes hereinafter complained of as made
6 by the defendant in this cause, and your orator brought suit against said Crane Brothers Manufacturing Company in the United States circuit court for said northern district of Illinois, in which suit said company appeared and answered and set up that said reissue 5027 was not surrendered for good and lawful cause, and that said reissue 8759 is not for the same invention as said original patent 118,617, nor for any distinct part of the thing therein patented, and averred and claimed that said reissue 8759 was therefore void; and also set up that said reissue had been unlawfully enlarged and made to cover things not included in said original patent. Said answer also averred want of novelty and invention in the bush claimed in said reissue 8759, and set up English patent to Taylor, No. 1955, of 1864; English patent to Hurrell, No. 648, of 1867; United States patents to Miller, No. 63076, of March 19, 1867; to Kenyon & Menzies, No. 38830, of June 9, 1863; to C. C. Stremme, No. 76670, of April 14, 1868; to D. F. Fetter, No. 62189, of February 19, 1867, and to T. B. Smith, No. 24827, of July 19, 1859; and also that the same bush had been known to and used by G. V. Brecht and C. G. Stifel, of St. Louis, Missouri, and by D. F. Fetter at New York city; on all of which matters issue was joined and proofs taken, and said original patent 118,617 and reissue 5027 and the file wrapper and contents in the matter of said application for said reissue 8759 were put in evidence on the question of identity of invention as between the original and the reissued patents and the legality of said reissue 8759; and a hearing was had at which able counsel appeared for the defendants and urged upon the court all of said matters of defense set up in their answer, and especially that said reissue had been unlawfully enlarged and made to cover things not included in said original patent, the invalidity of said reissue for want of identity of invention with the original, the illegality of the surrender and cancellation of said reissue 5027, and the want of novelty in said bush as compared with the English and United States patents cited and set up in their answer; and the court, on such hearing, upon consideration of all of said matters of defense, found said reissue 8759 to be a good and valid patent, and sustained and upheld the same, and a final decree has been entered in said cause on said finding, awarding a perpetual injunction, restraining said defendants from further infringing said reissue 8759 during the term thereof, and the said defendants have since acquiesced in said decree and have taken a license under said reissue and paid your orator five hundred dollars for his damages, and in addition thereto his costs of suit, and have since paid your orator large sums for license fees under said license, and are still making monthly re-

ports to your orator and payment of royalty thereon for all of such bushes made and sold by them.

Your orator further shows that the said reissue 8759 has been in litigation in New York city; that suit was brought by your orator against Albert Zoller, of New York city, for making and selling bushes in infringement of the same; that the said Zoller appeared and defended said suit for a time, and set up all the matters hereinbefore specified and others, and took a large amount of testi-
7 mony, but developed nothing new by way of defense, and finally offered to settle and did settle and abandon his defense and has since acquiesced in your orator's rights under said patent, he having suffered your orator to take a perpetual injunction against him.

Your orator further shows that Isaac G. Johnson & Company, of Spuyten Duyvil, New York, also infringed upon said patent reissue 8759, and your orator brought suit against them therefor; that said Johnson & Company appeared and answered in said suit, but subsequently settled with your orator, and have withdrawn their answer and suffered a default to be taken against them with perpetual injunction, and are now paying a royalty of between three and four cents upon each bush made and sold by them for the privilege of making said bushes.

Your orator further shows that since obtaining the said reissue 8759 Eilbert Schumaker, one of the defendants in said suit that was appealed to the supreme court, infringed the same, and your orator brought suit against him in the United States circuit court for the northern district of Illinois and obtained an injunction by default, and said Schumaker has acquiesced in the same and quit the manufacture of said bushes, and also the sale of the same.

Your orator further shows that Messrs. Barlow & Condict, of Newark, New Jersey, also commenced the manufacture of bung bush after the supreme court decision in the Schumaker and Johnson case, and had invested largely in machinery adapted especially for the same, and on being advised of said reissue and threatened with suit abandoned the manufacture of said bushes in 1880 and have since not made any, in deference and acquiescence to your orator's rights under said reissued patent.

And also that one Bump and one Bullock, of Rochelle, Illinois, who were engaged in the manufacture since the date of said reissue, have quit the manufacture of the same and wholly acquiesced in your orator's exclusive rights under said patent reissue 8759.

Your orator further shows, on information and belief, that the defendant herein begun the manufacture, sale, or use of said bung bushes subsequent to the date of said reissue 8759, and since the decision of the supreme court in the Schumaker and Johnson case.

And your orator further shows unto your honors that since the 17th day of June, 1879, and at divers times and occasions between that time and time of filing this your orator's bill of complaint, the defendant herein, Paul Weidner, at Detroit, in the eastern district of Michigan, and elsewhere in the United States, well knowing the premises, and without any legal assignment, grant, or license there-

for, and in defiance of your orator's patent rights aforesaid, has made and constructed or caused to be made and constructed for use and has sold and is now making, constructing, using, and selling large numbers of bung bushes substantially like and upon the plan and principle and in imitation of and embracing in each of said bung bushes either the whole or one or more of the said inventions and improvements contained in said reissued letters patent No. 8759, as your orator is informed and believes, and the said defendant persists in so doing and refuses to desist, although warned and requested so to do, whereby great injury has resulted to your orator and great gains and profits to a large sum of money have accrued to
8 the said defendant from the use of your orator's exclusive rights, the full amount of which is unknown to your orator, but which in equity belong to your orator and should be accounted for by the said defendant as damages to your orator and paid over to your orator as the avails of his exclusive rights aforesaid and profits and gains which your orator would have derived from his said patent rights but for the unlawful acts of the said defendant.

To the end, therefore, that the said defendant may, if he can, show why your orator should not have the relief herein prayed, and may, but without oath, an answer on oath being hereby expressly waived, and according to the best and utmost of his knowledge, remembrance, information, and belief, full, true, direct, and perfect answer make to all and singular the premises, and that he may be decreed to account for and pay over to your orator all gains and profits realized by him, and also the damages suffered by your orator from the unlawful making, using, or vending the improvements vested in your orator as aforesaid, and that your honors shall increase the actual damages suffered by your orator to a sum equal to three times the amount of actual damages suffered under the circumstances of the willful and unjust infringement by said defendant as hereinbefore set forth, and that the defendant may be perpetually restrained by an injunction to be issued out of this honorable court from making, using, or vending any bung bushes containing the improvements and inventions secured as aforesaid to your orator or any material part thereof; and that your orator may have such other and further relief as equity may require and to your honors may seem meet;

And your orator prays also for a provisional or preliminary injunction restraining the defendant according to the prayer of this bill until the further order of the court—

May it please your honors to grant unto your orator a writ of injunction conformable to the prayer of this bill until the further order of this court, and also a writ of subpœna directed to the said defendant, Paul Weidner, and commanding him, at a certain time and under a certain penalty, to appear before your honors in this court, then and there to answer unto this bill of complaint and to abide by and perform such decree as the court shall make in the premises; and your orator will ever pray, etc.

GEORGE B. CORNELL.

MERRIAM & WHIPPLE,
Solicitors and of Counsel for Complainant.

Endorsed: 2909. United States circuit court, eastern district of Michigan. George B. Cornell *vs.* Paul Weidner. Bill of complaint. Filed in clerk's office April 30, 1884. Walter S. Harsha, clerk.

9 *Subpœna.*

Circuit Court of the United States of America for the Sixth Circuit and Eastern District of Michigan, Sitting in Chancery.

The President of the United States of America to Paul Weidner, of the city of Detroit, who is a citizen of the State and resident of the eastern district of Michigan:

You are hereby commanded to be and appear in the circuit court of the United States of America for the sixth circuit and eastern district of Michigan, sitting in chancery, before the judges thereof, at the district court-room, in the city of Detroit, on the first Monday of June next ensuing, then and there to answer unto a bill of complaint exhibited against you as defendant by George B. Cornell, of the city of Chicago, in the State of Illinois, and who is a citizen of said State, as complainant; and this you shall in nowise omit under the penalty of one thousand dollars.

Witness the Hon. Morrison R. Waite, Chief Justice of the Supreme Court of the United States, this 30th day of April, in the year of our Lord one thousand eight hundred and eighty-four, and of the Independence of the United States the one hundred and eighth.

[SEAL.] WALTER S. HARSHA, *Clerk.*

MEMORANDUM.—The above-named defendant is required to enter his appearance in this suit with the clerk of this court, at his office, in the city of Detroit, on or before the day on which this writ of subpœna is returnable; otherwise the bill of complaint in this cause will be taken *pro confesso* against said defendant.

WALTER S. HARSHA, *Clerk.*

EASTERN DISTRICT OF MICHIGAN, *ss:*

I hereby certify and return that on the 5th day of May, A. D. 1884, I served the within writ on Paul Weidner, defendant within named, at Detroit, in said district, by delivering to him personally a true copy thereof; also exhibiting this writ with the seal of the court impressed thereon, said copy having like memorandum appended thereto as is hereto appended.

S. S. MATTHEWS,
U. S. Marshal,
By A. S. MATTHEWS, *Deputy.*

Service	2 00
Copy	50
2 miles' travel	12
Fees	$2 62

2—240

Endorsed: No. 2909. Circuit court of the United States for the sixth circuit and eastern district of Michigan. In chancery. George B. Cornell *vs.* Paul Weidner. Subpœna. Filed in clerk's office May 6, 1884. Walter S. Harsha, clerk.

10 *Security for Costs.*

UNITED STATES OF AMERICA, } ss:
Eastern District of Michigan, }

Circuit Court, June Term, A. D. 1884. In Chancery.

GEORGE B. CORNELL *vs.* PAUL WEIDNER.

We enter ourselves security for costs in this cause, and promise to pay all costs which may accrue to the opposite party in this action or to any of the officers of this court; and in default of payment by the complainant of any costs ordered or adjudged to be paid by him hereby agree and stipulate that execution may issue against *my* property for any costs taxed against us.

Dated this 29th day of April, A. D. 1884.

MERRIAM & WHIPPLE.

Endorsed: 2909. Circuit court United States, eastern district of Michigan. George B. Cornell *vs.* Paul Weidner. Bond for costs. Filed April 30, A. D. 1884. Walter S. Harsha, clerk.

11 *Security for Costs.*

In the Circuit Court of the United States for the Eastern District of Michigan.

GEORGE B. CORNELL *vs.* PAUL WEIDNER.

We hereby become security of all costs to which the defendant may become entitled in the above cause.

May 20, 1884.

GRIFFIN & WARNER.

Endorsed: 2909. U. S. circuit court. George B. Cornell *vs.* Paul Weidner, security for costs. Filed in clerk's office May 20, 1884. Walter S. Harsha, clerk.

12 *Præcipe for Defendant's Appearance.*

In the Circuit Court of the United States for the Eastern District of Michigan. In Equity.

GEORGE B. CORNELL *vs.* PAUL WEIDNER.

To the clerk of said court:

Please enter the appearance of the defendant in the above-entitled cause by me as his solicitor.

Yours,

GEO. H. LOTHROP,
Solicitor for Defendant.

Detroit, 24th May, 1884.

Endorsed: 2909. U. S. circuit court, E. dist. of Mich. In equity. George B. Cornell *vs.* Paul Weidner. Entry of appearance of defendant. Filed in clerk's office May 24th, 1884. Walter S. Harsha, clerk.

13 *Entry of Defendant's Appearance.*

In the Circuit Court of the United States for the Eastern District of Michigan. In Equity.

In the Case of GEORGE B. CORNELL *vs.* PAUL WEIDNER.

MAY 24, 1884.

On reading and filing a *præcipe* signed by George H. Lothrop, solicitor for defendant, it is ordered that the appearance of said defendant be, and the same is hereby, entered.

WALTER S. HARSHA, *Clerk*,
By JNO. GRAVES, *Dep'y Clerk.*

14 *Plea.*

In the Circuit Court of the United States for the Eastern District of Michigan. In Equity.

GEORGE B. CORNELL *vs.* PAUL WEIDNER.

The plea of the defendant, Paul Weidner, to the bill of complaint of the complainant, George B. Cornell.

This defendant, by protestation, not confessing or acknowledging all or any of the matters and things in the said complainant's bill of complaint mentioned and contained to be true in such sort, manner, and form as the same are therein set forth and alleged, for plea to the whole of said bill, says—

1. That, as he is informed and believes, the drawings and specifications of the original and reissued letters patent mentioned in said bill of complaint and numbered 118,617, 5027, and 8759, granted to the said complainant and John Lacey, were in the words and figures set forth in the printed copies thereof annexed to this plea.

2. That the invention described and claimed in said original letters patent was the combination of a bung bush having a notch in the flange thereof with a wrench having a projection adapted to engage with the notch in the flange of the bush and having a core to fit within the bush and steady the wrench.

3. That the invention described and claimed in the reissued patent No. 5027 was a screw-threaded bung bushing having a notch in the flange thereof to permit the use with such bushing of a wrench such as was shown and described in said original patent.

4. That said reissued letters patent No. 8759 is for a different invention from that described and claimed in either the original or reissued letters patent hereinbefore named.

5. That at and after the date of said reissued patent No. 5027 bung bushing in all respects like the one shown and described in

said original patent, except that they had no notch in the flange, were openly and extensively used in the United States, and this defendant believes that said reissue No. 8759 was obtained solely to expand the claims of said reissue No. 5027 and thereby cover and monopolize the use of bushings not covered by the claims of said reissued patent.

Wherefore this defendant doth plead in bar to the whole of said bill that said reissued patent No. 8759 is not for the same invention as said original patent, was issued in violation of the statute, and is void, and prays the judgment of this honorable court whether he should be compelled to make any further answer to said bill of complaint, and prays to be hence dismissed with costs.

P. WEIDNER.

GEO. H. LOTHROP,
Sol'r for Defendant & of Counsel.

15 EASTERN DISTRICT OF MICHIGAN, } *ss:*
County of Wayne, }

Paul Weidner, being duly sworn, deposes and says that he is the defendant in the above-entitled cause; that the foregoing plea is not interposed for delay, and that he believes that the same is true in point of fact.

P. WEIDNER.

Sworn to and subscribed before me this twenty-fourth day of May, A. D. 1884.

SUMNER COLLINS,
Notary Public, Wayne County, Michigan.

I hereby certify that, in my opinion, the foregoing plea is well founded in point of law.

GEO. H. LOTHROP,
Counsel for Defendant.

SUMNER COLLINS. [SEAL.]

(Here follows diagram marked p. 16.)

17 UNITED STATES PATENT OFFICE.

JOHN LACEY and GEORGE B. CORNELL, of Chicago, Illinois; said Lacey assigns his right to said Cornell.

Improvement in Combined Bushes and Wrenches for Bungs.

Specification forming part of Letters Patent No. 118,617, dated August 29, 1871.

To all whom it may concern:

Be it known that we, John Lacey and George B. Cornell, of Chicago, county of Cook and State of Illinois, have invented a new and valuable improvement in metallic bushings for the bungs of casks,

[18.]

JOHN LACEY & GEORGE B. CORNELL.

Bush and Wrench for Barrels.

No. 118,617. Patented Aug. 29, 1871.

No. 240. Cornell Weidner } p. 16.

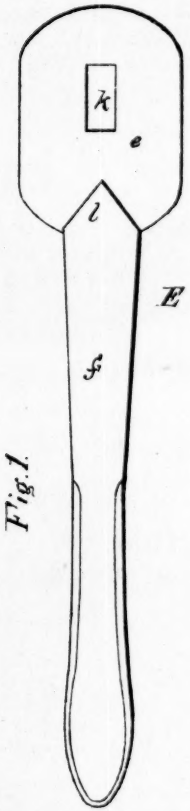

Fig. 1.

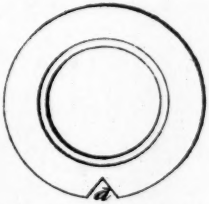

Fig. 2.

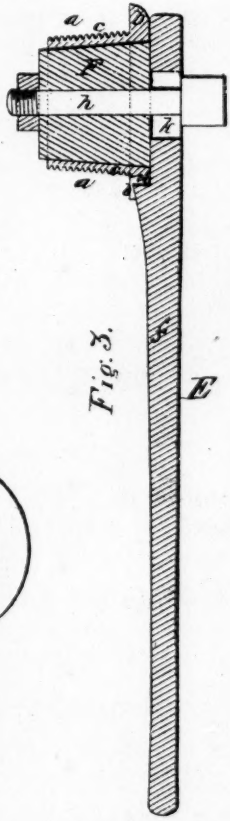

Fig. 3.

Witnesses.
Villette Anderson
E. H. Bates

Inventors
Jno. Lacey,
Geo B. Cornell,
Chipman & Somers
Attys.

J. LACEY & G. B. CORNELL.

Improvement in Bushes for Bungs.

No. 5,027. Reissued Aug. 6, 1872.

No. 240.
Cornell
v.
Weidner
p. 18

Fig 1

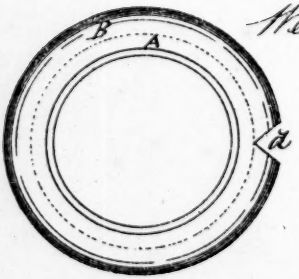

Fig 2

Witnesses:
N. W. Sherburne
J. W. Merriam

Inventor
George B. Cornell
by Sherburne & Co
Attorneys

&c., and in wrenches for operating the same; and we do hereby declare that the following is a full, clear, and exact description of the construction and operation of the same, reference being had to the annexed drawing making a part of this specification, and to the letters and figures of reference marked thereon.

Figure 1 is a bottom view of the wrench. Fig. 2 is a top view of the bushing; and Fig. 3 is a longitudinal section, showing the application of the wrench to the bushing.

Our invention has relation to means for protecting the bungs of casks, &c.; and it consists in an improvement in metallic bushings for lining the bungs, and in a wrench for turning said bushing, which is cast with a screw-thread, into the bung-hole.

a of the drawing designates the bushing—a tapering thimble or ring of metal, provided with a flanch, *b*, at its larger end, and having a screw-thread, *c*, on its outer surface, which screw-thread is cast on the bushing in the mold, and is capable of immediate use without other finishing. The flanch *b* is rounded off at its edge, and is provided at some point in its extent with a V-shaped notch, *d*, extending in to the screw-thread. E represents the wrench-bar, consisting of the slotted plate *e* and the shank *f*. The metal of the shank, at its junction with the plate, forms a downward V-shaped projection, *l*, whose point extends forward toward the center of the plate *e*. F represents a tapering core of metal, adapted to fit the bung-bushing *a*, and secured to the plate *e* by means of the bolt *h* and its nut. This core is made separable from the wrench-bar, in order that, by providing a number of cores of different sizes, the same wrench may be used for bushing of different diameters. Provision is also made, by the slot *k*, for moving the bolt toward the angular projection *l*, which becomes necessary when a smaller core is substituted for a larger one.

The wrench is applied by inserting the core into the opening through the bushing, and turning it until the projection *l* falls into the notch *d*. By means of the core the bushing is kept steady, and is readily prevented from assuming an oblique position in the bung-opening; at the same time the operator is enabled to get a better hold on the bushing than by means of the wrenches in common use, which are apt to slip from their seats when used on such difficult work as turning a rough-cast screw into place.

What we claim as our invention, and desire to secure by letters patent, is—

The combination, with the notched bung-bushing *a* of the wrench, consisting of the bar E having the slotted plate *e* and angular projection *l*, and the removable core F, substantially as specified.

JOHN LACEY.
GEORGE B. CORNELL.

Witnesses:
G. H. FROST.
WM. C. HASTINGS.

(Here follows diagram marked p. 18.)

19 UNITED STATES PATENT OFFICE.

JOHN LACEY and GEORGE B. CORNELL, of Chicago, Illinois; said Lacey assignor to G. B. Cornell.

Improvement in Bushes for Bungs.

Specification forming part of Letters Patent No. 118,617, dated August 29, 1871; Reissue No. 5027, dated August 6, 1872.

Division B.

To all whom it may concern:

Be it known that we, John Lacey and George B. Cornell, of Chicago, in the county of Cook and State of Illinois, have invented a new an improved metallic bushing for the bungs of barrels, casks, &c.; and we do hereby declare the following to be a full, clear, and exact description thereof, which will enable others skilled in the art to which the said invention appertains to make and use the same, reference being had to the accompanying drawing forming part of this specification, in which—

Figure 1 is a top view or plan of a bushing embodying the said improvement, and Fig. 2 is a vertical central section of the same.

Similar letters of reference indicate like parts in both figures of the drawing.

The said invention relates to means for protecting the bungs of barrels, casks, &c.; and the improvement consists in a metallic bushing for lining the periphery of the aperture, the arrangement of which will be more fully understood by the following description:

In the drawing, A represents the bushing proper, which consists of an annular ring of metal. This ring is made tapering on both its outer and inner sides, as shown in Fig. 2, and is screw-threaded upon its outer side, by which means the same is secured within the aperture in the cask. This thread may be formed by a suitable tool, or may be formed in the mold, as found most advantageous. The larger end of the said ring is provided with a flange, B, the outer surface or periphery of which is made in an ovolo shape, and is provided with a V-shaped notch, *d*, which extends inward to a point near the body of the ring, as shown in Fig. 1. The object of this notch is to allow a suitable wrench, adapted for the purpose, to engage therewith, whereby the said bushing may be turned into place without the wrench slipping from its seat, as would be the case with a bushing having a smooth surface. It will be observed by reference to the drawing that the aperture in the bushing is made larger at the end uniting with the flange than that of the opposite end, the object being to allow the stopper or bung to be more readily introduced, also to insure a more perfect fit by compressing the stopper as it is driven into place. It will also be observed that the outer side of the said ring or bushing is larger at the end uniting with the flange than the opposite end, the object being to allow the

J. LACEY & G. B. CORNELL,

Said LACEY assignor to said CORNELL.

Bush for Bung.

No. 8,759. **Reissued June 17, 1879.**

Fig. 1.

No. 2140. Cornell v. Weidner } p. 20.

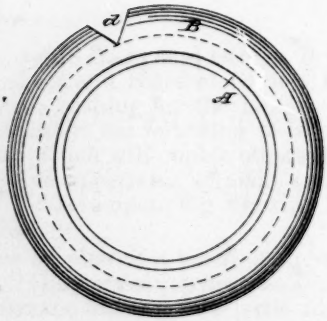

Fig. 2.

Attest:

Frederick F. Goodwin

Frank H. Baker

Inventor:

John Lacey

George B. Cornell

By Inott & Shuffle

atty

same to be more readily introduced into the aperture in the cask and to form its own thread in the wood as it is turned into place, thereby insuring a tight joint.

Having thus described our invention, we claim—

The screw-threaded metallic bung-bushing, made tapering upon both its outer and inner sides, and provided with the flange B having the V-shaped notch *d*, as and for the purpose described.

JOHN LACEY.
GEO. B. CORNELL.

Witnesses:
J. W. MERRIAM,
N. H. SHERBURNE.

(Here follows diagram marked p. 20.)

21 UNITED STATES PATENT OFFICE.

JOHN LACEY and GEORGE B. CORNELL, of Chicago, Illinois; said Lacey assignor to said Cornell.

Improvement of Bushes for Bungs.

Specification forming part of Letters Patent No. 118,617, dated August 29, 1871; Reissue No. 5027, dated August 6, 1872; Reissue No. 8759, dated June 17, 1879; application filed November 2, 1878.

To all whom it may concern:

Be it known that we, John Lacey and George B. Cornell, of Chicago, in the county of Cook and State of Illinois, have invented a new and improved metallic bush for bung-holes of barrels, casks, &c.; and we do hereby declare the following specification to be such full, clear, and exact description thereof as will enable others skilled in the art to which our said invention appertains to make and use the same, reference being had to the accompanying drawings, forming part of such specification, in which—

Figure 1 is a top or plan view of a bush embodying our said improvement, and Fig. 2 a vertical central section of the same.

Our invention relates to bushings for barrels; and consists of a short metallic tube in exterior form in shape of the frustum of a cone, slightly tapering. The outer surface is screw-threaded, to adapt it to be screwed forcibly into the bung-hole of the barrel, and to be held securely in place by the contact of the surfaces. The larger end of this tube is provided with an annular flange projecting outwardly, and adapted to rest, when the bushing is screwed to its place in the hole of the barrel, snugly upon the outer surface of the stave. The interior surface of the bushing is also made in the form of a frustum of a cone, and tapers uniformly from the exterior or flanged to the inner end of the bushing. This surface is made smooth and unbroken, and extends in such form quite through from one end of the bushing to the other, so that the wooden or compressible plug or

bung to which it is adapted may have a ready and unobstructed entrance, and may pass, if necessary, beyond the inner end of the bushing, and have a uniform bearing-surface throughout the entire length of the bushing.

We are aware that metallic bushings have been heretofore shown having an exterior threaded surface, tapering toward the inner end of the bushing, and an interior surface, also tapering toward the inner end, said interior surface having been either cut with slots or formed at the outer end with an annular recess, or having at the interior end inwardly projecting lips, these devices of the bush being adapted for use with metallic bungs.

Bushings so constructed we have never invented and do not desire to claim; nor do we desire to be understood as claiming a metallic bung-bush having at one end a flange, and tapering from its flanged end inwardly along both its plain interior and its screw-threaded exterior surfaces toward its smaller end, except when such interior surface is made unbroken, unobstructed, and uniformly tapering from end to end of the bush, and is thereby adapted to receive and hold a wooden or compressible bung.

Having thus described our invention, what we claim as new, and desire to secure by letters patent, is—

A metallic bushing for the bung-holes of barrels, made with a flange adapted to rest on the outer surface of the stave, and with an exterior threaded and an interior smooth surface, both tapering from the flanged to the interior end, said inner surface being unbroken and unobstructed, and tapering uniformly from one end of the bushing to the other, as and for the purpose set forth.

JOHN LACEY.
GEORGE G. CORNELL.

Witnesses:
MARCELLUS H. PITTS.
FLORISON D. PITTS.

22 *Replication.*

In the United States Circuit Court, Eastern District of Michigan.
June Term, A. D. 1884. In Chancery.

GEORGE B. CORNELL *vs.* PAUL WEIDNER.

The replication of George B. Cornell, complainant, to the plea of Paul Weidner, defendant.

This repliant, saving and reserving to himself, now and at all times hereafter, all and all manner of benefit and advantage of exception which may be had or taken to the manifold insufficiencies of the said plea of the said defendant, for replication thereunto says that he will aver, maintain, and prove his bill of complaint to be true, certain, and sufficient in the law to be answered unto, and that the said plea of the said defendant is uncertain, untrue, and insufficient to be replied unto by this repliant, without this, that any other mat-

ter or thing whatsoever in the said plea contained material or effectual in the law to be replied unto, and not herein and hereby well and sufficiently replied unto, confessed and avoided, traversed or denied, is true, and which matters and things this repliant is ready to aver, maintain, and prove as this honorable court shall direct, and humbly prays as in and by his said bill he has already prayed.

MERRIAM & WHIPPLE AND
GRIFFIN & WARNER,
Solicitors for Complainant.

Endorsed: 2909. United States circuit court, eastern district of Michigan. George B. Cornell *vs.* Paul Weidner. Replication. Filed this 5th day of July, A. D. 1884. Walter S. Harsha, clerk.

23 *Argued and Submitted.*

At a session of the circuit court of the United States for the eastern district of Michigan, continued and held, pursuant to adjournment, at the district court-room, in the city of Detroit, on Thursday, the twenty-third day of October, in the year one thousand eight hundred and eighty-four.

Present: The Honorable Henry B. Brown, district judge.

GEORGE B. CORNELL
vs.
PAUL WEIDNER. } In Equity.

This cause coming on for hearing on this day is argued by Mr. Merriam for complainant and Mr. George H. Lothrop for defendant, and submitted.

24 *Order Overruling Plea, &c.*

At a session of the circuit court of the United States for the eastern district of Michigan, continued and held, pursuant to adjournment, at the district court-room, in the city of Detroit, on Monday, the twenty-seventh day of October, in the year one thousand eight hundred and eighty-four.

Present: The Honorable Henry B. Brown, district judge.

GEORGE B. CORNELL
vs.
PAUL WEIDNER. } In Equity.

This cause, having been heretofore heard and submitted upon the defendant's plea filed to the complainant's bill, and due deliberation having been thereupon had, it is by the court now here ordered that the said plea be, and the same is hereby, overruled, with leave to the defendant to file his answer on or before the first Monday in December. It is further ordered that the case be argued on its merits before a full bench, with liberty to reargue the question raised by the plea.

25 *Opinion of District Judge.*

Circuit Court of the United States for the Eastern District of Michigan. In Equity.

GEORGE B. CORNELL *vs.* PAUL WEIDNER.

Had the issue tendered by the plea in this case been originally presented to this court I should have been disposed to hold the plea to be good, upon the authority of Schumaker *vs.* Cornell, 69 U. S., 555; Johnson *v.* R. R. Co., 105 U. S., 545, and James *v.* Campbell, 104 U. S., 370, as it seems to me the omission of the notch is a material expansion of the original claim; but it is averred in the bill and legally admitted by the plea that this reissued patent was adjudged to be valid by the learned and experienced circuit judge of the 7th circuit in a case arising in the northern district of Illinois, wherein the question was distinctly presented by the pleadings and decided by the court. This decision was pronounced after the opinion of the Supreme Court had been published in Schumaker *v.* Cornell. Its correctness appears also to have been acquiesced in by various parties who have been prosecuted in other districts for infringement of the plaintiff's patent.

Under these circumstances I deem it my duty to defer to the opinion of Judge Drummond, to overrule this plea, and to give the defendant until the December rule day to file his answer. I shall, however, direct the case to be argued upon its merits before a full bench, with liberty to reargue the question raised by the plea.

Endorsed: 2909. Cornell *vs.* Weidner. Opinion of Judge Brown. Filed Oct. 27, 1884. Walter S. Harsha, clerk.

26 *Transcript from Files, Reissue No.* 8759.

Old pat.; 1 ds.; $30, check.

DEPARTMENT OF THE INTERIOR,
UNITED STATES PATENT OFFICE.

To all persons to whom these presents shall come, Greeting:

This is to certify that the annexed is a true copy from the files of this office of the reissue letters patent granted John Lacey and George B. Cornell, said Lacey assignor to said Cornell, June 17, 1879, number 8759, for improvement in bushes and bungs.

In testimony whereof I, R. G. Dyrenforth, acting Commissioner of Patents, have caused the seal of the Patent Office to be affixed this 13th day of October, in the year of our Lord one thousand eight hundred and eighty-four, and of the Independence of the United States the one hundred and ninth.

[SEAL.] R. G. DYRENFORTH,
Acting Commissioner.

27 To the Commissioner of Patents:

Your petitioners, of Chicago, in the county of Cook and State of Illinois, pray that they may be allowed to surrender the letters patent for an improvement in bushes for bungs, reissue No. 5027, granted August 6, 1872, to George B. Cornell, who is now the sole owner thereof and on whose behalf this application is made, and that letters patent may be reissued to the said George B. Cornell, one of your petitioners, for the same invention, upon the annexed amended specification, and they hereby appoint John H. Whipple, of Chicago, State of Illinois, their attorney, with full power of substitution and revocation, to prosecute this application, to make alterations and amendments therein, to receive the patent, and to transact all business in the Patent Office connected therewith.

Accompanying this petition is an abstract of title duly certified as required in such cases.

JOHN LACEY.
GEORGE B. CORNELL.

28 To all whom it may concern:

Be it known that we, John Lacey and George B. Cornell, of Chicago, in the county of Cook and State of Illinois, have invented a new and improved metallic bush for bung-holes of barrels, casks, &c., and we do hereby declare the following specification to be such full, clear, and exact description thereof as will enable others skilled in the art to which our said invention appertains to make and use the same, reference being had to the accompanying drawings, forming part of such specification, in which—

[Figure 1 is a top or plan view of a bush embodying our said improvement and Fig. 2 a vertical central section of the same.

Our said invention relates to means for protecting bung-holes and the improvement consists in a metallic bush for lining the periphery of bung-holes, the construction of which bush will be more fully understood from the following description:

Substitute "A," Apr. 2, '79.

In the drawings A represents the bush, which consists of an annular ring of metal made tapering on both its outer and inner sides, as shown in Fig. 2, and screw-threaded on its outer side to enable it to be screwed into a bung-hole. This screw-thread may be cut by a suitable tool or is formed in the mould, as found most advantageous. The larger end of the bush is provided with a flange, B, whose outer surface or periphery is made in an oval shape and provided with a notch, D, as shown in Fig. 1.

The object of this notch is to provide a means in the bush of uniting it with the wrench employed to screw the bush into place in the bung-hole, but we do not wish to confine ourselves to this particular means in the bush of uniting it with the wrench, as any mechanical means which will unite the bush firmly with the wrench so that the bush may be controlled by the wrench and screwed properly into the bung-hole will produce the desired result.

It will be observed by reference to the drawings that the orifice of the bush is made larger at the flanged than at the opposite end, the

interior being smooth and tapering, the object being to allow the bung or stopper to be more readily introduced and to insure a more perfect fit by compressing the bung as it is driven into place. It will also be observed that the outer side or screw-threaded portion of the bush is larger at the flanged end than at the opposite end, the object being to allow the bush to be more readily introduced into the bung-hole and to form its own thread in the wood of the stave as the bush is screwed into place, thereby securing a tight joint between the bush and the stave.

Having thus described our invention, what we claim is—

A metallic bush for bung-holes having a smooth, tapering interior periphery, a screw-threaded, tapering exterior periphery, and a flange B, substantially as and for the purpose specified.]*

JOHN LACEY.
GEORGE B. CORNELL.

Witness:
JNO. H. WHIPPLE.
FREDERICK C. GOODWIN.

29 STATE OF ILLINOIS, } ss:
County of Cook, }

John Lacey and George B. Cornell, the above-named petitioners, being duly sworn, depose and say that they verily believe, and each for himself deposes and says that he verily believes, that by reason of an insufficient or defective specification the aforesaid letters patent are inoperative or invalid; that the said error has arisen from inadvertence, accident, or mistake and without any fraudulent or deceptive intention, to the best of his or their knowledge and belief, and that your petitioner, George B. Cornell, on whose behalf this application is made, is the sole owner of the said letters patent, and that they believe, and each of them believes, themselves to be the first, original, and joint inventors of the improvement set forth and claimed in this amended specification.

JOHN LACEY.
GEORGE B. CORNELL.

Subscribed and sworn to by the said John Lacey and George B. Cornell on this 15th day of July, 1878, before me—

[SEAL.] JOHN H. WHIPPLE,
Notary Public.

30 To the Commissioner of Patents:

We hereby amend the accompanying application hereto annexed by striking out from the 2nd page of the specification lines 9 to 19, both inclusive, with the lines intervening, and inserting the following in lieu thereof, viz:

["The object of this notch is to make the bush conform to the wrench described in reissue, division A, to this patent, employed in the operation of screwing the bush into the bung-hole."]*

* Words and sentences enclosed in brackets erased in original.

Also amend by adding two claims, as follows:

"A metallic bush for bung-holes, made tapering on the outside and inside, smooth on the inside and screw-threaded on the outside, and having the flange *b* with the notch *d*, substantially as and for the purpose specified.

Canceled Dec. 27, '78.

"3. The combination, with a flanged bung bush, made tapering inside and outside and smooth inside and screw-threaded outside, during the operation of screwing such bush into a bung-hole, of the tapering cylindrical core described in wrench patent reissue, division A, to this patent, inserted into the bore of such bush and mechanism to firmly connect the wrench and bush so as to cause such wrench and bush to revolve together and prevent the bush from assuming an oblique position in the bung-hole while being screwed in, substantially as specified."

Canceled Dec. 9, '78.

JOHN LACEY,
GEORGE B. CORNELL,
By JOHN H. WHIPPLE, *Att'y.*

31 THE UNITED STATES PATENT OFFICE.

To all persons to whom these presents shall come, Greeting:

This is to certify that careful search has been made of the digest of this office and no assignment, agreement, license, power of attorney, or other instrument of writing is found of record under or relating to reissue letters patent granted to John Lacey and George B. Cornell, said Lacey assignor to said Cornell, No. 5027, August 6, 1872, for "bush for bungs."

In testimony whereof I, W. H. Doolittle, acting Commissioner of Patents, have caused the seal of the Patent Office to be hereunto affixed this twenty-eighth day of October, in the year of our Lord one thousand eight hundred and seventy-eight, and of the Independence of the United States the one hundred and third.

[SEAL.]

W. H. DOOLITTLE,
Acting Commissioner.

32 Room 103.

No. 13138.

DEPARTMENT OF THE INTERIOR,
UNITED STATES PATENT OFFICE.
WASHINGTON, D. C., *Nov.* 12, 1878.

Lacey and Cornell, care John H. Whipple, present:

Bushes for bungs. Nov. 4, 1878.

The 1st and 2nd claims are rejected on each of the several following patents: C. C. Stremme, 76670, April 14, 1868; Lichtenstadt and Pentlarge, 102,285, April 26, 1870, and John Miller, 63076, Mar. 19, 1867—bungs.

The 3rd claim is rejected for — that the subject-matter of it is neither shown nor described. Elements of a claim may not be imported into this case from "reissue, division A." Furthermore, there is no combination of this bush with that wrench any more than with any other wrench. For each of these reasons, severally, the claim is rejected.

S. W. STOCKING, *Examiner.*
PURMAN, *3rd Ass't Ex'r.*

33 CHICAGO, *Dec. 5th*, 1878.

Com'r of Patents, Washington, D. C.

DEAR SIR: Enclosed herewith please find amendment of claims to the application of Lacey & Cornell.

Regarding the references cited on the 1st & 2nd claims, it does not seem to me that any of them meets the 2nd claim, which has the special feature of the notch *d*, not found in the references cited.

Nor does it seem that the first claim is met by the references. It is a specific claim. Miller approaches the nearest to it, but his bush is not tapering on the inside, unless it be tapering from the opposite end. What is the date of the oath and of filing the application of the Miller patent cited, No. 63076? I wish to know in reference to having an interference declared in case it is found identical with the first claim of Lacey and Cornell, as they claim, and it is the fact that they completed the bush in 1866, but that it was not put into use until 1869, when the wrench was perfected, by which the bush was made practical and useful. This has been well established by plenary proof and in a well-contested case.

The devices cited in bar to the present application all approximate more or less closely to Lacey and Cornell, but none of them ever went into practical use or is practical or useful for the purpose. Mess. Lacey & Cornell were the first to make this bush a practical and useful thing, and they want the specific features of their bush to distinguish it from those which are impractical and valueless. The bush must be tapering inside & out from the flange end, smooth inside, screw-threaded outside.

Yours, JNO. H. WHIPPLE.

34 Room No. 103.

13138.

DEPARTMENT OF THE INTERIOR,
UNITED STATES PATENT OFFICE,
WASHINGTON, D. C., *Dec.* 10, 1878.

Lacey and Cornell, care Jno. H. Whipple, Chicago, Ill.:

Bushes for bungs. Nov. 4, 1878.

The 1st and 2nd claims are a 2nd time rejected on the references cited. Miller fully meets the terms of the 1st claim, the claim not defining the taper of applicants' bush—*i. e.*, whether the opening on the inside of the bush grows larger from the bottom toward the top

or *vice versa*. The bushes of the other two references taper as applicants' does.

Miller has the two notches "D D." There is nothing patentable in omitting one of them. "G G" are notches in "102,285" to receive a suitable wrench; so are "E E" in "76670."

The date of the oath and of the filing of "63076" will necessarily appear in the interference which will arise, if applicants do not avoid the references by properly restricting the terms of their claims to any new invention.

S. W. STOCKING, *Examiner*.
PURMAN, *3rd Ass't Ex'r*.

35 *Application* 13138.

In the Matter of the Application of GEORGE B. CORNELL & JOHN LACEY, filed Nov. 4, 1878, for reissue of patent for bushes for bungs.

CHICAGO, *Dec. 5th*, 1878.

To the Commissioner of Patents:

Please amend by striking out the 3rd claim.

JOHN H. WHIPPLE, *Att'y*.

36 CHICAGO, *Dec.* 23, 1878.

Com'r of Patents, Washington, D. C.

DEAR SIR: Enclosed please find amendment in the application of Lacey & Cornell, which, I think, is sufficiently specific to escape the Miller patent cited in bar of the former claims, at least, if not the others, which, as I understand them, have not the smooth interior surface which would make the tight joint by having an ordinary wooden bung driven in.

Yours, JNO. H. WHIPPLE.

June 21, '71.

37 CHICAGO.

To the Commissioner of Patents:

Please strike out the claims of our application 13138 for patent for improvement in bushes for bung-holes and substitute—

[A metallic bush for lining bung-holes, having a smooth, tapering interior periphery, a screw-threaded, tapering exterior periphery, and a flange, *b*, projecting from the outer surface around one end, said bush being largest in both its inside and outside diameter at its flanged end and being tapering both inside and outside from said flanged towards the opposite end, substantially as and for the purpose specified.]*

JOHN LACEY,
GEORGE B. CORNELL,
By JNO. H. WHIPPLE, *Att'y*.

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* Words and sentences enclosed in brackets erased in original.

38 Room No. 103.

DEPARTMENT OF THE INTERIOR,
UNITED STATES PATENT OFFICE,
WASHINGTON, D. C. *Jan'y* 3, 1879.

Lacey & Cornell, care John H. Whipple, Chicago, Ill.:

Bushes for Bungs. Reissue, Nov. 4, 1878.

The amended claim has avoided none of the references; that it has not avoided 102,285 & 76670 is too plain to require comment. It has not avoided Miller by limiting to a metallic bush, metallic bushes being old before Miller. This attempted limitation amounts merely to the substitution of a material known to have been used for the same object. The limitation to a bush "tapered inside and out from the flanged to the opposite end" is a matter of degree only, for whether Miller's taper extend a part or all of the way across his bush the operation is the same.

Believing from previous amendments that it is applicant's intention to avoid Miller, it is suggested that to do it the claim in the premises ought to distinctly lay the two tapers as severally diminishing the exterior and the interior diameter of the bush as they advance toward the unflanged end. This might be done by inserting after "bush being largest" the words "in both its inside and outside diameter." This would avoid Miller, but would not avoid either of the other references cited.

As applicant has manifested an intention to contest priority of invention with these references, it becomes necessary to cite all cases which may anticipate him; consequently the following additional references are cited: U. S. pat. to W. Calhoun, No. 85903, Jan'y 19, 1869, bungs; and English patent, No. 648, A. D. 1867, to Hurrell.

S. W. STOCKING, *Examiner.*

39 CHICAGO, *Jan.* 11*th.* (Torn off.)

Com'r of Patents, Washington, D. C.:

Enclosed please find amendment in Cornell & Lacey matter adopting the last suggestion of the office regarding the claim.

You say the Calhoun device may anticipate.

We desire to contest priority of invention, and would of course like to have the issues confined to as few parties as there is clearly any conflict between. We did not think Calhoun would come in, but says he "may."

Yours, JNO. H. WHIPPLE.

40 CHICAGO, *Jan.* 11, 1879.

Com'r of Patents.:

In the matter of the application of John Lacey & George B. Cornell for reissue, filed Nov. 4, 1878, for improvement in bushes for bungs, applicants adopt the suggestion of amendment made in last

official letter by inserting after "bush being largest" the words "in both its inside and outside diameter."

JOHN LACEY,
GEORGE B. CORNELL,
By JOHN H. WHIPPLE, *Att'y.*

41 Room 103.

DEPARTMENT OF THE INTERIOR,
UNITED STATES PATENT OFFICE,
WASHINGTON, D. C., *Jan'y* 15, 1879.

Lacey & Cornell, care John H. Whipple, Chicago, Ill.:

The claim is rejected on Stremme, Lichtenstadt and Pentlarge, Calhoun, and the English patent, all once before cited.

Should applicants desire, an interference will be declared with the above patents.

S. W. STOCKING, *Ex'r.*

42 CHICAGO, *Jan.* 25, 1879.

Com'r of Patents, Washington, D. C.

DEAR SIR: Your communication of the 15th inst. *in re.* Lacey and Cornell application, filed Nov. 4, '78, is just received, bushes for bungs; applicants claim to have made the invention claimed before any of the parties named in the references cited as a bar to the claim and desire to contest the question of priority of invention as between themselves and said patents.

Yours, JNO. H. WHIPPLE.

43 Room No. 103.

DEPARTMENT OF THE INTERIOR,
UNITED STATES PATENT OFFICE,
WASHINGTON, D. C., *Feb.* 4, 1879.

Lacey & Cornell, care Jno. H. Whipple, Esq., Chicago, Ill.:

Reissue appl'n bung, div. A. Nov. 2, 1878.

It was error to say that an interference would be declared with the British patent No. 648, A. D. 1867, sealed Aug. 30, 1867. This reference must stand, unless applicants present their affidavits, duly made before a properly-authorized person, to the effect that the invention of their application in the premises setting forth that invention in the terms of the claim was invented and used by them prior to Aug. 30, 1867, the date of sealing of the Eng. patent. Such action will avoid the reference.

S. W. STOCKING, *Examiner.*

44 CHICAGO, *Feb.* 6, 1879.

Commissioner of Patents, Washington, D. C.

DEAR SIR: Enclosed herewith I send you the affidavit of Geo. B. Cornell in the matter of the application of Lacey and Cornell for bungs, filed Nov. 4, '78.

Mr. Lacey is now working at Marseilles, Illinois, and we will have to send there for his affidavit if required; but I presume the affidavit of Cornell will be sufficient.

There is no doubt about Lacey & Cornell's having made this invention in the summer of 1866. This was proved to the satisfaction of Judge Drummond here in a well-contested case on the patent being reissued; but I will send aff't of Lacey if it is required. We want to speed the case as much as possible.

JNO. H. WHIPPLE.

45 IN THE U. S. PATENT OFFICE,
WASHINGTON, D. C.

In the Matter of the Application of JOHN LACEY and GEORGE B. CORNELL for letters patent for improvement in bushes for bungs. Filed November 4, 1878.

STATE OF ILLINOIS, }
Cook County, } *ss:*

George B. Cornell, being duly sworn, says that he is one of the applicants above named in the matter above entitled, and that he and said John Lacey were the original and joint inventors of the device claimed in this application, viz., a metallic bush for lining bung-holes, having a smooth, tapering interior periphery, a screw-threaded, tapering exterior periphery, and a flange, *b*, projecting from the outer surface around one end, said bush being largest in both its inside and outside diameters at its flanged end, and being tapering both inside and outside from said flanged towards the opposite end, substantially as claimed, and that such invention by said Lacey and deponent was made and perfected and used by them privately prior to the 30th day of August, 1867.

GEORGE B. CORNELL.

Subscribed and sworn to this 6th day of February, A. D. 1879, before me—

[L. S.] JOHN H. WHIPPLE,
Notary Public.

46 *Interference.*

Room No. 103.

DEPARTMENT OF THE INTERIOR,
UNITED STATES PATENT OFFICE,
WASHINGTON, D. C., *Feb.* 15, 1879.

John Lacey and G. B. Cornell, Chicago, Ill.:

Please find below a copy of a communication from the examiner concerning your app'n for reissue of reissue patent No. 5027, filed Nov. 4, 1878, original appl'n filed June 21, 1871, bung bush.

Very respectfully, H. E. PAINE,
Commissioner of Patents.

Your case above referred to is adjudged to interfere with patents to C. C. Stremme, No. 76670, Apr. 14, '68, application filed Mar. 21, 1867; Lichtenstadt and Pentlarge, No. 102,285, Apr. 26, 1870, appl'n filed Feb. 14, 1870; W. Calhoun, No. 85903, Jan. 19, 1869, appl'n filed Oct. 8, 1868, and the question of priority will be determined in conformity with the rules accompanying this. The preliminary statement demanded by rule 53 must be sealed up and filed on or before the 17 day of March, 1879, with the subject of the invention and name of party filing it indorsed on the envelope. The subject-matter involved in the interference is a metallic bung bush, having at one end an outwardly projecting flange and tapering from the flanged end inwardly along both its plain interior and its screw-threaded exterior surfaces towards its smaller end, claimed by you and appearing in each of the patents.

Stremme's address is Austin, Texas; his attorney of record is G. W. Paschal, No. 76 Mo. Ave., Washington, D. C. Lichtenstadt's address is Brooklyn, N. Y.; Pentlarge's is city of New York; their att'y is Munn and Co., Washington, D. C. Calhoun's address is West Troy, N. Y.; his att'y, A. Selkirk, Albany, N. Y.

S. W. STOCKING, *Ex'r.*

47 *Interference.*

Room 103.

DEPARTMENT OF THE INTERIOR,
UNITED STATES PATENT OFFICE,
WASHINGTON, D. C., *Feb.* 15, '79.

Lacey and Cornell, care Jno. H. Whipple, Esq., Chicago, Ill.:

Please find below a copy of a communication from the examiner concerning your appl'n for reissue of reissue patent No. 5027, filed Nov. 4, 1878, original appl'n filed June 21, 1871, bung bush.

Very respectfully, H. E. PAINE,
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Room No. 103.

Your case above referred to is adjudged to interfere with patents to C. C. Stremme, No. 76670, Apr. 14, '68, appl'n filed Mar. 21, 1867; Lichtenstadt and Pentlarge, No. 102,285, Apr. 26, '70, appl'n filed Feb. 14, 1870; W. Calhoun, No. 85903, Jan'y 19, 1869, appl'n filed Oct. 8, 1868, and the question of priority will be determined in conformity with the rules accompanying this.

The preliminary statement demanded by rule 53 must be sealed up and filed on or before the 17th day of March, 1879, with the subject of the invention and name of party filing it endorsed on the envelope. The subject-matter involved in the interference is a metallic bung bush, having at one end an outwardly projecting flange and tapering from the flanged end inwardly along both its plain interior and its screw-threaded exterior surfaces towards its smaller ends, claimed by you and appearing in each of the patents.

Stremme's address is Austin, Texas; his att'y of record is G. W. Paschal, No. 76 Mo. Ave., Washington, D. C. Lichtenstadt's address is Brooklyn, N. Y.; Pentlarge's is the city of New York; their att'y is Munn & Co., N. Y. — Wash'n, D. C.

Calhoun's address is West Troy, N. Y.; his att'y, A. Selkirk, Albany, N. Y.

S. W. STOCKING, *Ex'r.*

48 To the Commissioner of Patents:

Please recognize J. W. Merriam, of Chicago, Illinois, and Ellis Spear, of Washington, D. C., as associate attorneys with me and with like powers in the matter of the application of Lacey and Cornell for the reissue of reissued letters patent No. 5027 for bung bushes, filed Nov. 4, 1878.

JOHN H. WHIPPLE,
Att'y for John Lacey and George B. Cornell.

49 In the Matter of the Application of JOHN LACEY and GEO. B. CORNELL for a reissue of patent No. 5027, filed Nov. 4, 1878—bushes for bungs.

Before the Com'r of Patents in person.

To the Commissioner of Patents.

SIR: We herewith submit an amendment in the matter of our application for a reissue of patent No. 5027, for improvement in "bushes for bungs," said application having been filed on the 4th day of November, 1878.

The amendment is intended to limit the claim to the precise invention shown in our patent. We believe that our invention is a distinct and clear improvement upon the devices shown in the prior patents with which our application for a reissue has been placed in the interference—the time for preliminary statements not yet expired—and that the distinguishing features of our invention, to which the claim is now limited, are not shown in any of the aforesaid patents.

If we are correct in this behalf, then there is no conflct between the claims submitted and the said patents. We desire, therefore, to obtain the final judgment of the office upon this claim before going through a long, and perhaps expensive, interference, of the favorable result of which we feel confident, but which we think unnecessary. We ask, therefore, that the interference be sustained and our application referred to the primary examiner for consideration, together with the amended claim.

Respectfully submitted.

JOHN LACEY,
GEORGE B. CORNELL,
By ELLIS SPEAR, *Att'y.*

Approved for consideration.
M'ch 3rd, 1879.

W. H. DOOLITTLE, *A'ct'g Com'r.*

50 To the Commissioner of Patents:

We hereby amend our application for a reissue of patent 5027, for improvement in bushes for bungs, filed Nov. 4, 1878, as follows:

Insert before the claims—

We are aware that metallic bushings have been shown having an exterior threaded surface tapering toward the inner end of the bushing and an interior surface also tapering toward the inner end, said interior surface having been either cut with slots or formed at the outer end with an annular recess or obstructed at the interior end by inwardly-projecting lips, these devices of the bush being adapted for their use with metallic bungs. Bushings so constructed we do not desire to claim.

Erase claim, and substitute—

A metallic bushing for the bung holes of barrels, made with an outside flange adapted to rest upon the stave of the barrel, with an exterior frusto-conical threaded surface and a like interior smooth unbroken surface extending from end to end, adapted to receive and hold a compressible plug, the inner and outer diameters being smaller at the inner end of the bushing.

Respectfully,

JNO. LACEY,
GEO. B. CORNELL,
By ELLIS SPEAR, *Att'y.*

March, 1879.

51 Room No. 103.

DEPARTMENT OF THE INTERIOR,
UNITED STATES PATENT OFFICE,
WASHINGTON, D. C., *M'ch* 4, 1879.

Lacey & Cornell, care Ellis Spear, and J. W. Merriam, present.

LACEY AND CORNELL, Reissue Applicants,
vs.
LICHTENSTADT *et al.*, Patentees.

In preliminary interference.

The amendment approved by the ass't com'r for consideration of the examiner cannot be received into the application of Lacey & Cornell for the following reasons:

The rules forbid its acceptance. See rules No. 60, 61, and the last sentence of No. 68.

From these rules it appears that disclaimer is the only amendment, save that allowed in rule 61, which is admissible to an application pending an interference, and that a disclaimer must be such as will avoid the issue of the interference and must be signed by the applicants in person.

The amendment not coming within rules 61 or 68 is prohibited by rule 60.

S. W. STOCKING, *Ex'r.*

52 Room No. 103.

13138.

DEPARTMENT OF THE INTERIOR,
UNITED STATES PATENT OFFICE,
WASHINGTON, D. C., *M'ch 11th*, 1879.

Lacey & Cornell, care Ellis Spear, present.

LACEY & CORNELL *vs.* LICHTENSADT *et al.*

This interference is dissolved on the ground that its subject-matter was known and used by other than the parties hereto in this country, and was patented in a foreign country prior to the appearance in this office of either of the parties to this proceedings.

S. W. STOCKING, *Ex'r.*

53 Room No. 103.

13138.

DEPARTMENT OF THE INTERIOR,
UNITED STATES PATENT OFFICE,
WASHINGTON, D. C., *M'ch* 11, 1879.

Lacey & Cornell, care Ellis Spear, present.

Reissue of bung bush, Nov. 4, 1878.

The pending claim—formerly the issue of the interference—is now rejected on patents to Calhoun, Lichtenstadt, and Pentlarge and Stramme, all heretofore cited.

It is further rejected as an aggregation of the bush of each of the first group of patents following, with the means for fastening the bush in the sleeve, shown by each patent of the second group following:

First group, each showing the bush fastened by other than applicant's means: T. Summerfield, No. 47877, May 23, 1865; Kenyon and Menzies, No. 38830, June 9, 1863; D. F. Fetter, No. 62189, Feb. 19, 1867, and No. 91618, June 22, 1869, and White and Shilrock, No. 73856, Jan'y 28, 1868.

2nd group, each showing a bung for a bush fastened to the stave by applicant's means—*i. e.*, a screw thread on the exterior of the bung or bush: T. B. Smith, July 19, 1859, No. 24857; Hufendeck and Spangenbery, No. 60011, Nov. 27, 1866, and English, No. 1878, A. D. 1863.

The claim is further rejected on English No. 1878, A. D. 1863, last above cited, and severally on English patent No. 1955, A. D. 1864. U. S. references are in bungs, save Summerfield, which is in bung wrenches.

S. W. STOCKING, *Ex'r.*

54 Hon. Com. of Patents.

SIR: Referring to our application for reissue of patent for bung bushing filed ——, 1878, we file herewith an amendment containing specification and claims, which we wish to substitute for those previously filed.

We desire to limit our claims by specific disclaimer and corresponding restrictions of specification in order to avoid conflict with the patents with which our application has been heretofore adjudged by the office to interfere.

We submit the case thus amended for such action as the office may deem proper. In regard to the differences relied upon by us and specially pointed out, we desire to state—

First. That they are such that no person, even unskilled in the art, can, for a moment, mistake one for another.

Second. Our device—a specific improvement like those in the patents cited in letter of preliminary interference—is a true and genuine improvement.

It serves a purpose of which no one of those referred to are practically capable.

The trade clearly shows that we have made a new, clearly distinguishable, and useful invention—made better by the specific differences. Having limited our claims by definite terms and by disclaimer, we ask as speedy action as the rules of the office and due consideration of the rights of the patentees with whom we were thought to interfere will permit. As no "interference proper" has been declared—rule 59, 2nd par.—and no disclosure of their case been made to us by the other parties cited, we presume no judgment of priority is called for; and no such rights on their part having been interposed, we assume that the office may act independently of any of those parties in dissolving the preliminary interferences as it did in creating it.

JOHN LACEY,
GEORGE B. CORNELL,
By ELLIS SPEAR, *Attorney.*

55 To the Commissioner of Patents.

SIR: In the matter of our application for patent for bung bushing, filed Nov. 4, 1878—

Erase commencing after words "section of the same," line 19, page 1, through the claims and substitute:

> Our invention relates to bushings for barrels, and consists of a short metallic tube in exterior form in shape of the frustum of a cone, slightly tapering. The outer surface is screw-threaded to adapt it to be screwed forcibly into the bung-hole of the barrel, and to be held securely in place by the contact of the surfaces.
>
> The larger end of this tube is provided with an annular flange projecting outwardly and adapted to rest, when the bushing is screwed to its place in the hole of the barrel, snugly upon the outer surface of the stave.

The interior surface of the bushing is also made in the form of the frustum of a cone, and tapers uniformly from the exterior or flanged to the inner end of the bushing. This surface is made smooth and unbroken, and extends in such form quite through from one end of the bushing to the other, so that the wooden or compressible plug or bung to which it is adapted may have a ready and unobstructed entrance, and may pass, if necessary, beyond the inner end of the bushing and have a uniform bearing surface throughout the entire length of the bushing.

"A." Insert M, page 1. We are aware that metallic bushings have been heretofore shown having an exterior threaded surface tapering toward the inner end of the bushing and an interior surface, also tapering toward the inner end, said interior surface having been either cut with slots or formed at the outer end with an annular recess or having at the interior end inwardly-projecting lips, these devices of the bush being adapted for use with metallic bungs.

Bushings so constructed we have never invented and do not desire to claim, nor do we desire to be understood as claiming a metallic bung bush having at one end a flange and tapering from its flanged end inwardly along both its plain interior and its screw-threaded exterior surfaces toward its smaller end, except when such interior surface is made unbroken, unobstructed, and uniformly tapering from end to end of the bush, and is thereby adapted to receive and hold a wooden or compressible bung.

Having thus described our invention, what we claim as new, and desire to secure by letters patent, is—

A metallic bushing for the bung-holes of barrels made with a flange adapted to rest on the outer surface of the stave and with an exterior threaded and an interior smooth surface, both tapering from the flanged to the inner end, said inner surface being unbroken and unobstructed and tapering uniformly from one end of the bushing to the other, as and for the purpose set forth.

JOHN LACEY.
GEORGE B. CORNELL.

Witness:
MARCELLUS H. PITTS.
FLORISON D. PITTS.

53 To the Hon. Com'r of Patents.

SIR: I desire to call the attention of the examiner to the amendment filed on the 11 ult. in the application of Lacey and Cornell for improvement in bung bushing. As the action of the examiner was based upon the claim pending before the filing of the amendment referred to, I desire before taking any further action in the case, should such action be necessary, to have his judgment upon the claim now before the office.

Respectfully,

LACEY AND CORNELL,
By ELLIS SPEAR, *Attorney.*

57 Room No. 103.

13138.

DEPARTMENT OF THE INTERIOR,
UNITED STATES PATENT OFFICE,
WASHINGTON, D. C., *Apr. 2nd*, 1879.

Lacey & Cornell, care Ellis Spear, present:

Bushes for bungs. Reissue. Nov. 4, 1878.

The amendment offered M'ch 11, '79, has been entered. The last official communication, the rejection of April 11, '79, was directed to the merits of the case and is equally applicable to the amended application as now existing; hence this application is rejected on the references and reasons given in the official letter of M'ch 11, '79. If applicant desires he can consider this a second rejection on the same references and reasons.

S. W. STOCKING, *Ex'r.*

58 To the Commissioner of Patents:

SIR: In the matter of the application of John Lacey and G. B. Cornell for reissue of patent for bung bushing, said applica- having been filed Nov. 4, 1878, I respectfully request a reconsideration of the claim last submitted. I desire also to submit for the consideration of the examiner some suggestions touching the said claim and the state of the art which he has disclosed to us.

I think it may be safely assumed that the English patent, No. 1955, of 1864, is the reference most nearly in point and the only apparent bar worthy of serious consideration against the issue of a patent to Lacey and Cornell with the claim now presented by them. Undoubtedly the other references show elements which, being selected and combined into one bung bushing, would make the bung bushing of the applicants, and it is equally certain that not one of them, either in construction or operation, either to make or use, is the same as the simple and efficient bung bushing of Lacey and Cornell. The difference between their bushing and that of the references under consideration, excluding the English patent specified, is palpable and plain, and it is such a difference precisely which makes the bung bushing of Lacey and Cornell better than all the others—so much better that it is sold in large quantities, and the others are not sold at all and cannot be sold in the same market with it. Perhaps so much as this need not be said in relation to those references. I apprehend that it is not upon them that the examiner relies, although they are properly in the case to illustrate the state of the art.

Turning now to the English patent of 1864, No. 1955, it is to be observed that it is clearly a patent for bung bushing. Bung bushings of different shapes are clearly shown and described in it, but not the bung bushing of applicants as a bung bushing. What is described as a bung bushing the examiner would not have admitted for a moment as a reference to our claim, and it is not upon the bung bushing shown by this English patent that he relies.

In connection with this bushing is shown an air vent having some essential elements of my client's invention. The primary object of the perforated plug which forms the specific reference in this patent appears to have been to provide a screw which might serve to hold the bushing to the stave and at the same time afford a vent hole for the admission of the air to the interior of the barrel. This is plainly shown in Fig. 6 of the English drawing, where the plug is inserted through an ear on the flange of the bung bushing and through the stave of the cask and is held by a nut on the inside. The modification of this is shown in Fig. 1, which figure has the general likeness of shape but not identically of proportion with the device of my clients. This device shown in Fig. 1 of the English patent is not a bung bushing, and I venture to say that if the examiner had found it anywhere else than in a patent for bung bushing he would have excluded it from his list of references. Had it been intended as a plug anywhere else than in a barrel it might not have been thought of. But can the
59 accident of its location give it any force or pertinency not inherent in the nature of the thing itself. Now, I think it may be fairly stated, as I have said above, that in no ordinary use of the terms, as applied amongst those skilled in the art, can this device in Fig. 1 of the English patent be called a bung bushing, as represented in the drawing, and evidently the drawing gives about the proper proportions for actual use; it is a little above five-eighths of an inch in diameter. The diameter of the hole is but little more than one-eighth of an inch, while the ordinary bung bushing is an inch and seven-eighths in interior diameter, but the difference is not in size alone by any means; the proportions are altogether different. A bushing made in the proportions shown in Fig. 1 of the English drawing enlarged three or four diameters would not make a bung bushing by reason of the enlargement; it could not be used or sold as a bung bushing.

But if it be not itself the article which is shown and claimed by Lacey and Cornell it cannot be used as a reference to defeat a patent for their invention, unless it be so clearly and unmistakably an analogous thing as to infallibly suggest to those skilled in the art at once the invention of applicants, substantially as made and used by them; or, to put the matter in plainer light and by more exact statement, since the specification and drawings of this patent amount to no more in law than a published description—no use having been shown, unless this description and this drawing set forth in such full, clear, and exact terms the precise useful invention—that is to say, the improved bung bushing shown by these applicants, so that any one skilled in the art could have made the invention and used it for the purpose intended without communication from them, then it is not a bar.

No one is more familiar with this doctrine than the examiner, and it need not be enforced or illustrated by citation of authorities. I think it only pertinent to observe that it must not be a matter of guess whether or not the published description would clearly convey the invention and put the public in possession of it. It must be a

matter of certainty; if there be any doubt about it the applicants are entitled to the allowance of their claim.

Now, what are the facts relating to the question of the fullness and clearness of this English specification and drawing to convey to the public? The invention of Lacey and Cornell is a valuable one; it has been put upon the market by the hundred thousand annually. It has driven all others out of the market, and recognition of its worth is abundant and certain; but all this use and all this recognition of use, in fact the thing itself, has appeared only since Lacey and Cornell took out their original patent, and originated in them. It was unheard of before in the market; yet this English patent had been published and scattered aboard more than seven years before Lacey and Cornell received their patent. If this English patent certainly and fully described the invention then the invention was open to the public in this country without money or price, and yet, valuable as it was, they refused to touch it. What, since the invention of Lacey and Cornell, is eagerly contended for, before their invention, if it existed before, was passed by as worthless, though all the makers and users of the class of barrels to which this
60 invention is applicable all over the country were seeking for some remedy for the evil which this invention effectually remedies, although it may effect a saving of hundreds of thousands of dollars annually.

But there is another consideration of still greater force. Not only did this English patent never suggest to the manufacturers and users of beer and other barrels the invention of Lacey and Cornell, but it did not even occur to the inventor himself to make such a bung bushing as these applicants have given to the public. The slightest comparison instituted between the bushings shown in this English patent and that shown by applicants will make it appear that the merit is altogether in favor of my clients. It is safe to say that the form shown in that patent was never used to any considerable extent. It certainly never would be used in this country where applicant's device could be procured. But if it be thus plainly a better bushing than any shown in the English patent, why did not the English inventor describe and illustrate our invention? Why did he not enlarge the diameter and thin the wall and give depth to the screw-threads, and change the proportion of diameter and length, and alter the relative width of the flange and make this peg plug a bung bushing? A valuable invention was almost in his grasp, as has happened to inventors a thousand times before, why did he not put forth his hand and secure it? There can be only one reason. It never occurred to him; our invention was never in his mind. It is not the custom of English inventors to omit any good modification which occurs to them. The examiners' class, better than any other, bears record to their fertility and discursiveness in this respect, and the English patent office imposes no restrictions upon their prolixity.

But if this pin hole, shown in Fig. 1, did not suggest, even to the originator of it, our invention, how shall it be assumed that it discloses it even to the attentive public?

It is no very strong argument, but it is singularly pertinent to this line of argument, and singularly in accordance with what I conceive to be the true theory of the case, that this patent of 1864 was not regarded by English inventors as disclosing the invention of my clients. The invention was made subsequently by an English inventor, although subsequently to the invention of our clients, but prior to their patent. It appears in the English patent of Hurrell, No. 648, dated August, 1867. It is fair to assume that when the 1864 patent had been three years before the English public Hurrell, an inventor in the same line, had not found the invention of my clients in it or he would not have paid the exorbitant fees in English patent cases for an invention already before the public. Hurrell does not show it in the same form as it is shown in the English patent of 1864, but goes straight to the invention, as shown by my clients.

I submit, therefore, that this article, the advantages of which are manifest and great, which has superseded all others of its class, is not to be denied the merit of patentability because the elements of it are shown in other combinations and separate and distinct; further, that the English patent of 1864 is not such a description of the invention as would enable any one skilled in the art to make
61 and use it, but does disclose another thing, which is not the invention, but which is so distinct from it as not to be mistaken by anybody for the invention, which, as a matter of fact, never has suggested the invention to anybody, so far as there is any evidence whatever. The precise thing covered by the claims, which is the only valuable invention of the kind disclosed yet anywhere in this art, originated with Lacey and Cornell.

After maturely considering the whole state of the art as disclosed by the search of the examiner we confidently ask the allowance of the claim, and shall confidently stand upon the patent if allowed. The references which approach the invention from one side or the other are numerous, but the mere number of them is of no weight. References are not to be counted, but weighed, and no number of bad reasons will make one good one. We are not insisting upon a mere difference to which we attach no special importance and for which we can give no good reason. The differences which exist between the references and the invention of my clients as made and used by them are exactly the differences which make their invention valuable. To these specific differences the claim is distinctly limited.

Respectfully submitted,

LACEY AND CORNELL,
By ELLIS SPEAR, *Attorney.*

62 Room No. 103.

DEPARTMENT OF THE INTERIOR,
UNITED STATES PATENT OFFICE,
WASHINGTON, D. C., *May 15th*, 1879.

Bung bush. Reissue, Nov. 4, 1878.

Lacey and Cornell, care Ellis Spear, present:

The able arguments which present forcibly the favorable points on behalf of applicant *has* been maturely considered. Yet the office is compelled by its judgment to the conclusion that the reasons and references of letter of M'ch 11, 1878, should prevail against the alleged novelty herein. Accordingly the case is a second time rejected on these references and reasons.

S. W. STOCKING, *Ex'r.*

63 13178. 1878. Div. 14.

Reissue No. 8759.

John Lacey and George B. Cornell, said Lacey assignor to said Cornell, of Chicago, county of Cook, State of Illinois.

Bushes for bungs.

Rec'd Nov. 2, 1878.
Petition, " " "
Affidavit, " " "
Specification, " " "
Drawing, " " "
Abstract of title, Nov. 4, 1878.
Old patent reissue No. 5027, Aug. 6, 1872.
Cert. dep.
Cash, $30, Nov. 3, 1878.
Examined M'ch 27, '79, by the board.
Issue, May 29, '79, F. A. Seeley.
Patented Aug. 29, 1871.
Reissue, Aug. 6, 1872.
Reissued June 17, 1879.
Circular, May 29, 1879.

JOHN H. WHIPPLE,
Chicago, Ill.

Ellis Spear, asso., present.
J. W. Merriam, asso., Chicago, Ill.

64 1878.

Contents.

Application papers.
1. Am'd't, Nov. 2, '78.
2. Rejection, Nov. 12, '78.

3. App'ts' letter, Dec. 9, 1878.
4. Am'd't, Dec. 9, '78.
5. 2nd rej., Dec. 10, '78.
6. Am'd't, Dec. 27, '78.
7. Rej., Jan'y 3, '79.
8. App'ts' letter, Jan'y 14, '79.
9. Am'd't, Jan'y 14, '79.
10. Rej., Jan'y 15, '79.
11. Letter to office, Jan'y 28, '79.
12. Letter, Feb'y 15, '79.
13. Affidavit, Feb. 14, '79.
14. Am'd't and letter, Mar. 3, '79.
15. Both refused admission in the case.
16. Letter, Mar. 4, '79.
    Dissolved Mar. 11, '79.
17. Rejected Mar. 11, '79.
18. App'ts' letter, Apr. 1, '79.
    Letter of Mar. 11 entered Apr. 2, '79.
    Am'd't of Mar. 11 entered Apr. 2, '79.
    Rej., Apr. 2, '79.
    App'ts' letter, May 13, '79.
    2nd rej., May 15, '79.
    Appeal to board, May 16, '79.
    Answer, May 16, '79.
    Examined May 27, '79.

Title: Improvement in bushes for bungs.
Ex'd: J. A. W., M. McK.

(Here follows diagram marked p. 65.)

66 UNITED STATES PATENT OFFICE.

JOHN LACEY and GEORGE B. CORNELL, of Chicago, Illinois; said Lacey assignor to said Cornell.

Improvement in Bushes for Bungs.

Specification forming part of Letters Patent No. 118,617, dated August 29, 1871; Reissue No. 5027, dated August 6, 1872; Reissue No. 8759, dated June 17, 1879; application filed November 2, 1878.

To all whom it may concern:

Be it known that we, John Lacey and George B. Cornell, of Chicago, in the county of Cook and State of Illinois, have invented a new and improved metallic bush for bung-holes of barrels, casks, &c.; and we do hereby declare the following specification to be such full, clear, and exact description thereof as will enable others skilled in the art to which our said invention appertains to make and use the same, reference being had to the accompanying drawings, forming part of such specification, in which—

Figure 1 is a top or plan view of a bush embodying our said improvement, and Fig. 2 a vertical central section of the same.

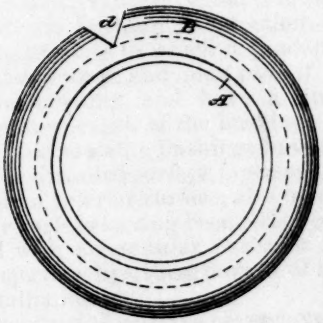
J. LACEY & G. B. CORNELL,

Said LACEY assignor to said CORNELL.

Bush for Bung.

No. 8,759. Reissued June 17, 1879.

Fig. 1.



No. 2440.
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Weidner
p. 65

Fig. 2.

Attest:

Frederick F. Goodwin
Frank H. Parker

Inventor:

John Lacey
George B. Cornell
By Jno. H. Whipple
atty

Our invention relates to bushings for barrels; and consists of a short metallic tube in exterior form in shape of the frustum of a cone, slightly tapering. The outer surface is screw-threaded, to adapt it to be screwed forcibiy into the bung-hole of the barrel, and to be held securely in place by the contact of the surfaces. The larger end of this tube is provided with an annular flange projecting outwardly, and adapted to rest, when the bushing is screwed to its place in the hole of the barrel, snugly upon the outer surface of the stave. The interior surface of the bushing is also made in the form of the frustum of a cone, and tapers uniformly from the exterior or flanged to the inner end of the bushing. This surface is made smooth and unbroken, and extends in such form quite through from one end of the bushing to the other, so that the wooden or compressible plug or bung to which it is adapted may have a ready and unobstructed entrance, and may pass, if necessary, beyond the inner end of the bushing, and have a uniform bearing-surface throughout the entire length of the bushing.

We are aware that metallic bushings have been heretofore shown having an exterior threaded surface, tapering toward the inner end of the bushing, and an interior surface, also tapering toward the inner end, said interior surface having been either cut with slots or formed at the outer end with an annular recess, or having at the interior end inwardly-projecting lips, these devices of the bush being adapted for use with metallic bungs.

Bushings so constructed we have never invented and do not desire to claim; nor do we desire to be understood as claiming a metallic bung-bush having at one end a flange, and tapering from its flanged end inwardly along both its plain interior and its screw-threaded exterior surfaces toward its smaller end, except when such interior surface is made unbroken, unobstructed, and uniformly tapering from end to end of the bush, and is thereby adapted to receive and hold a wooden or compressible bung.

Having thus described our invention, what we claim as new, and desire to secure by letter patent, is—

A metallic bushing for the bung-holes of barrels, made with a flange adapted to rest on the outer surface of the stave, and with an exterior threaded and an interior smooth surface, both tapering from the flanged to the inner end, said inner surface being unbroken and unobstructed, and tapering uniformly from one end of the bushing to the other, as and for the purpose set forth.

JOHN LACEY.
GEORGE B. CORNELL.

Witnesses:
MARCELLUS H. PITTS.
FLORISON D. PITTS.

67 *Motion for Modification of Order for Reargument.*

In the Circuit Court of the United States for the Eastern District of Michigan. In Equity.

GEORGE B. CORNELL *vs.* PAUL WEIDNER.

And now comes the said defendant, by George H. Lothrop, his solicitor, and moves the court that the order heretofore made in this cause on the twenty-seventh day of October, A. D. 1884, be so modified as to order a reargument of the plea filed in said cause before a full bench of said court before said defendant shall be required to make further answer to the bill of complaint in this cause.

This motion is based upon the opinion of the court expressed in said order as to the validity of the reissued patent sued upon in this cause.

Detroit, 3rd Nov.

GEO. H. LOTHROP,
Sol'r for Def't.

The Circuit Court of the United States for the Eastern District of Michigan. In Equity.

GEORGE B. CORNELL *vs.* PAUL WEIDNER.

Please take notice that on Monday, the seventeenth day of November, A. D. 1884, at the opening of said court, in the forenoon of said day, or as soon thereafter as counsel can be heard, I shall bring on for hearing a motion in the above-entitled cause, a copy of which is herewith served on you.

Yours,

GEO. H. LOTHROP,
Sol'r for Def't.

Detroit, 3rd Nov., 1884.

To Messrs. Merriam & Whipple sol'rs for compl't.

68 *Motion to Modify Order Overruling Plea Argued, &c.*

At a session of the circuit court of the United States for the eastern district of Michigan, continued and held, pursuant to adjournment, at the district court-room, in the city of Detroit, on Monday, the seventeenth day of November, in the year one thousand eight hundred and eighty-four.

Present: The Honorable Henry B. Brown, district judge.

GEORGE B. CORNELL,
vs.
PAUL WEIDNER. } In Equity.

In this cause a motion by defendant to modify order overruling plea is argued by counsel for respective parties and submitted.

69

Order for Reargument before Full Bench.

At a session of the circuit court of the United States for the eastern district of Michigan, continued and held, pursuant to adjournment, at the district court-room, in the city of Detroit, on Friday, the twenty-first day of November, in the year one thousand eight hundred and eighty-four.

Present: The Honorable Henry B. Brown, district judge.

GEORGE B. CORNELL
vs.
PAUL WEIDNER. } In Equity.

It is ordered that this cause be reargued before a full bench upon the issues raised by the plea.

70

Final Decree.

At a session of the circuit court of the United States for the eastern district of Michigan, in equity, continued and held, at the court-room in the city of Detroit, on Wednesday, the twenty-fifth day of March, A. D. 1885.

Present: Hon. John Baxter, circuit judge, and Hon. Henry B. Brown, district judge.

GEORGE B. CORNELL
vs.
PAUL WEIDNER. } In Equity.

Before Judge Baxter.

This cause having come up for argument on the bill, plea, and proofs therein, and the court having heard the counsel for complainant and having declined to hear counsel for defendant, it is now ordered, adjudged, and decreed that reissued letters patent No. 8759, granted to John Lacey and George B. Cornell for improvement in bushes for bungs on the seventeenth day of June, A. D. 1879, is not for the same invention as the original of said reissued letters patent, and is void.

And it is further ordered, adjudged, and decreed that the bill of complaint in this cause be dismissed with costs.

71

Order Allowing Claim of Appeal.

At a session of the circuit court of the United States for the eastern district of Michigan, continued and held, pursuant to adjournment, at the district court-room, in the city of Detroit, on Wednesday, the twenty-fifth day of March, in the year one thousand eight hundred and eighty-five.

Present: The Honorable John Baxter, circuit judge, and the Honorable Henry B. Brown, district judge.

GEORGE B. CORNELL
vs.
PAUL WEIDNER. } In Equity.

Before Judge Baxter.

Now comes the said plaintiff, by Merriam & Whipple, his solicitors, and claims an appeal to the Supreme Court of the United States from the decree of this court dismissing the bill of complaint; which appeal is by the court now here allowed and the bond on appeal is hereby fixed at $500, to be filed within 60 days.

72 *Defendant's Bill of Costs.*

In the Circuit Court of the United States for the Eastern District of Michigan. In Equity.

GEORGE B. CORNELL *vs.* PAUL WEIDNER.

Counsel for hearing	$20 00
Counsel fee on depositions of Geo. B. Cornell & E. Thormann	5 00
	$25 00

We hereby consent to the taxation of the foregoing bill of costs at $25.00.

MERRIAM & WHIPPLE,
Chicago, April 1, 1885. *Sol'rs for Compl't.*

Endorsed: 2909. U. S. circuit court, E. dis't of Mich. In equity. Geo. B. Cornell *vs.* Paul Weidner. Def't's bill of costs. I hereby tax def't's costs at $25.00. Walter S. Harsha, clerk. Filed April 4, 1885. Walter S. Harsha, clerk.

73 *Bond on Appeal.*

Circuit Court of the United States, Eastern District of Michigan. In Equity.

GEORGE B. CORNELL *vs.* PAUL WEIDNER.

Know all men by these presents that George B. Cornell and Richard T. Crane, of the city of Chicago, county of Cook, and State of Illinois, and James Harvey, of the city of Detroit, county of Wayne, and State of Michigan, are held and firmly bound unto Paul Weidner, of the said city of Detroit, in the penal sum of five hundred dollars, lawful money of the United States; for the payment of which, well and truly to be made, we bind ourselves, our heirs, executors, and administrators, jointly and severally, firmly by these presents.

Witness our hands and seals this 7th day of April, A. D. 1885.

The condition of the above obligation is such that whereas, on the 25th day of March, A. D. 1885, the said circuit court of the United States for the eastern district of Michigan entered a final decree in

the above-mentioned cause, from which decree said George B. Cornell, the complainant, has taken an appeal to the Supreme Court of the United States:

Now, therefore, if the said George B. Cornell shall duly prosecute the said appeal with effect and shall pay all damages and costs that may be awarded against him in case the said decree shall be affirmed in the said Supreme Court of the United States, then the above obligation shall be void; otherwise to remain in full force and effect.

GEORGE B. CORNELL. [SEAL.]
JAMES HARVEY. [SEAL.]
RICHARD T. CRANE. [SEAL.]

Approved:
HENRY B. BROWN,
Dist. Judge.

Endorsed: 2909. Circuit court of the United States, eastern district of Michigan. George B. Cornell *vs.* Paul Weidner. Bond filed April 29, 1885. Walter S. Harsha, clerk.

74 THE UNITED STATES OF AMERICA:

The Circuit Court of the United States for the Eastern District of Michigan.

I, Walter S. Harsha, clerk of the circuit court of the United States for the eastern district of Michigan, do hereby certify and return to the claim of the defendant to an appeal to the Supreme Court of the United States of the case of George B. Cornell against Paul Weidner that the above and foregoing is a true copy of the record and proceedings of the said court in said cause; that I have compared the same with the original, and it is a true and correct transcript therefrom and of the whole thereof.

In testimony whereof I have hereunto set my hand and affixed the seal of said court, at Detroit, in said district, this fifteenth day of June, in the year one thousand eight hundred and eighty-five, and of the Independence of the United States of America the one hundred and ninth.

[Seal of the Circuit Court, Eastern District of Michigan.]

WALTER S. HARSHA, *Clerk.*

Endorsed on cover: E. Michigan C. C. U. S. No. 240. George B. Cornell, appellant, *vs.* Paul Weidner. Filed July 2, 1885.

27-261

Supreme Court U.S.
DEC 8 1887
JAMES H. McKENNEY,
CLERK.

—IN THE—

SUPREME COURT

OF THE

UNITED STATES.

OCTOBER TERM A. D., 1887.

No. 240.

GEORGE B. CORNELL, *Appellant,*

vs.

PAUL WEIDNER, *Appellee.*

Appeal from the U. S. Circuit Court of the Eastern District of Michigan.

BRIEF AND ARGUMENT FOR APPELLANT.

J. W. MERRIAM,
Solicitor for Cornell.

JOHN H. WHIPPLE,
of Counsel.

CHICAGO:
S. W. Roth Printing and Stationery Co., 171 & 173 Randolph Street.
1887.

—IN THE—

SUPREME COURT

OF THE

UNITED STATES.

OCTOBER TERM A. D., 1887.

No. 240.

GEORGE B. CORNELL, *Appellant,*

vs.

PAUL WEIDNER, *Appellee.*

Appeal from the U. S. Circuit Court of the Eastern District of Michigan.

BRIEF AND ARGUMENT FOR APPELLANT.

I.

STATEMENT OF FACTS.

This was a bill filed asking for an injunction and accounting, for the infringement of U. S. Reissued Letters Patent, No. 8759, by repeated sales of the patented device.

The only defence made was a plea that the reissue 8759 was not for the same invention as the original patent. Assuming that all the allegations of the bill not controverted by the plea are true, the record shows that letters patent, No. 118,617, were granted to the appellant as assignee of himself, and one John Lacey, August 29,

1871, for an improvement in *combined* Bushes and Wrenches for Bungs. (Rec., 1, 12.) That on the 6th day of August, 1872, patent No. 118,617 was for good and lawful cause surrendered and reissued in two divisions, A and B: division A No. 5026 being for the Wrench separately, and division B No. 5027 being for the Bush separately. (Rec., 1,14.) That on the 17th day of June, 1869, reissue No. 5027 was for good and lawful cause surrendered and reissue No. 8759 granted for the unexpired term of the original patent. (Rec., 2, 15.)

That the form of bung bush described and claimed in reissue 8759 was not known or used prior to the invention of it by the appellant and Lacey; that appellant and Lacey invented and applied said bush; and that prior to that time no metallic lining for bung holes had been successfully applied, though attempts had repeatedly been made. That appellant brought the same into general use throughout the United States. And that this bush or lining has been supplied to nearly every brewer in the United States, and is the only bush or lining in use, and has been of great benefit and value to the public. (Rec., 3, 22, 31, 36.)

In December, 1872, about two months after the grant of the first reissues, 5026 and 5027, appellant brought a suit for infringement against Schumaker & Johnson, in the Eastern District of Wisconsin, the alleged infringement being the manufacture and sale of a core wrench without any projection to engage a notch in the flange of the bush. This was adjudged by the court to be an infringement of the reissued patent, and a decree with reference to a master was entered in the case, and in the computation of damages before the master, the number of bushes which had been inserted without any notch in the flange was shown and made the basis for computing damages. And that the Circuit Court was of opinion that reissue

5027 was entitled to a construction which would include and cover the bush, when made without the notch in the flange. That in suits brought in the Circuit Court for the Northern District of Illinois, one against Gillette *et al.* and one against the Downer & Bemis Brewing Co., in 1874, on both the reissued patents, 5026 and 5027, the same construction was given and adhered to by the court, and that the public generally acquiesced in that construction until the decision by the Supreme Court of the case of Schumaker *v.* Cornell, in the winter of 1877-8, indicating that the claim of reissue 5027, covered only the bush having a notch in the flange, and that thereupon without delay reissue 5027 was surrendered and reissue 8759 was obtained. (Rec., 3, 4, 5.)

It also appears that in the re-examination of the case had upon the application for reissue 8759, the commissioner of patents rejected the claim therein made for the bush with a notch in the flange, for want of patentable novelty. (Rec. 5, 20, 21, 23.) And that the appellee began the manufacture, sale and use of said bung bushes, subsequent to the date of reissue 8759, (Rec., 7.)

II.

ASSIGNMENT OF ERRORS.

I. The court erred in finding the reissued patent in suit not for the same invention as the original of said reissued patent.

II. The court erred in finding reissued patent No. 8759 void.

III. The finding of the court is contrary to the law and the evidence in the cause.

IV. The court erred in dismissing the bill of complaint in this cause.

III.

BRIEF.

1. A plea in bar to the whole bill must reduce the issue to a single point.

Beames' Equity, 10.
1 Daniels, Chy., 603, *n.* 4.
Rhode Island v. *Massachusetts*, 14 Pet., 261.
Powder Co. v. *Powder Co.*, 19 Fed. R., 513.

2. All other defenses, except the one made by the plea, are cut off.

Walker on Patents, § 605.
Pitts v. *Hall*, 2 Blatch., 229.
Blandy v. *Griffith*, 2 Fish., 616.

3. The bill, so far as it is not contradicted by the plea, is admitted to be true.

Beames' Eq., 48.
Story's Eq. Pl., § 694.

4. The single point put in issue by the plea in this cause is:—Is the reissued patent No. 8759 for the same invention as the original patent No. 118,617?

(SEE ARGUMENT, POST PAGE 7.)

5. The identity of the invention set forth in the original and reissued patents is a matter of legal construction on a comparison of the two instruments.

(SEE ARGUMENT, POST PAGE 12.)

Seymour v. *Osborne*, 11 Wall., 516.
Stevens v. *Pritchard*, 10 O. G., 505.
Lamp Heater Co. v. *Littell*, 13 O. G., 1009.
Tucker v. *Tucker M'f'g Co.*, 4 Cliff., 397.
Albright v. *Cel. Harness T. Co.*, 12 O. G., 228.

6. A comparison of the two patents for the purpose of determining the question of identity of invention re-

quires an interpretation of the original patent in the light of the state of the art.

(SEE ARGUMENT, POST PAGE 8 to 12.)

Lachus v. *Broomall*, 115 U. S., 429.
Vance v. *Campbell*, 1 Black, 427.
Garneau v. *Dozier*, 12 Otto, 230.

7. The notch in the flange was not an essential feature of the bush invention, but could be left out, and the essential characteristics of the invention remain unaltered.

(SEE ARGUMENT, POST PAGE 14 to 17.)

Carver v. *Braintree Mfg. Co.*, 2 Story, 439.
Gong Bell Co. v. *Clark*, 13 O. G., 275.
Fruit House Co. v. *Busch*, 2 Biss., 472.
Morey v. *Lockwood*, 8 Wall., 130.
Dorsey Rake Co. v. *Marsh*, 6 Fish., 398.

8. Under the circumstances shown in this case, there was no unjustifiable delay in applying for reissue 8759.

(SEE ARGUMENT, POST PAGE 17 to 20.)

O'Riley v. *Morse*, 15 How., 62, 120, 121.
Gage v. *Herring*, 2 S. C. R., 819.
Seymour v. *McCormick*, 19 How., 106.
Powder Co. v. *Powder Co.*, 19 Fed. R., 512.

9. The patentee had a right to broaden the claim of the original in the reissue, to make it cover the actual invention.

(SEE ARGUMENT, POST PAGE 20 to 26.)

Odell v. *Stout*, 22 Fed. R., 159.
Seymour v. *Marsh*, 2 O. G., 675.
Fruit House Co. v. *Busch*, 2 Biss., 472.
Miller v. *Brass Co.*, 14 Otto, 350.
James v. *Campbell*, 14 Otto, 356.
Driven Well Cases, 7 S. C. R., 1081.
La Bau v. *Hawkins*, 6 O. G., 725.

Rubber Co. v. *Goodyear*, 9 Wall., 788.
Battin v. *Taggert*, 17 How., 74.
Gong Co. v. *Clark*, 13 O. G., 275.
Crandall v. *Parker C. G. Co.*, 20 Fed. R., 851.
Coburn v. *Schroeder*, 22 O. G., 1538.
W. U. Tel. Co. v. *B. & O. Tel. Co.*, 25 Fed. R., 32, 35, 36.
Thomas v. *Shoe Mfg. Co.*, 16 O. G., 542.
Becker v. *Hastings*, 22 Fed. R., 827.
Morey v. *Lockwood*, 8 Wall., 230.
Brown v. *Guild*, 23 Wall., 181.
Bennett v. *Fowler*, 8 Wall., 445.
Marsh v. *Seymour*, 97 U. S., 366.
Dorsey Co. v. *Marsh*, 6 Fish., 387.
Poppenhausen v. *Falk*, 2 Fish., 213-220.

10. The presumption of the law is in favor of the identity of the original and reissue.

(SEE ARGUMENT, POST PAGE 26 to 28.)

Thomas v. *Shoe Mfg. Co.*, 16 O. G., 541.
O'Riley v. *Morse*, 15 How., 112.
Guidet v. *Barber*, 5 O. G., 149.
Bantz v. *Elsas*, 6 O. G., 118.
Felting Co. v. *Haven*, 3 Dill., 131.
La Bau v. *Hawkins*, 6 O. G., 725.
Carver v. *Braintree Mfg. Co.*, 2 Story, 439.
Allen v. *Blunt*, 3 Story, 742.
Seymour v. *Osborne*, 11 Wall, 544-5.
Smith v. *Goodyear D. V. Co.*, 3 Otto, 486.

IV.

ARGUMENT.

I.

1. *A plea in bar to the whole bill must reduce the issue to a single point.*

2. *All other defenses, except the one made by the plea, are cut off.*

3. *The bill, so far as it is not contradicted by the plea, is admitted to be true.*

The above three points we assume will be conceded. The law relating to them is too familiar to the court to justify discussion.

4. *The single point put in issue by the plea in this cause is:—Is the reissued patent No. 8759 for the same invention as the original patent No. 118,617?*

This we presume will be conceded. The first paragraph of the plea is not controverted. The second and third paragraphs appear to us to be wholly inconsequential—the *second*, because the surrender and reissue admits and adjudicates that the invention "described and *claimed*" in the original patent was defectively claimed, and that the claim did not cover the invention described, because two distinct and not co-acting devices were claimed in combination, and because the reissue, 8759, is only for one of the devices described in the original, being for a distinct and severable part of the assumed combination claimed; and the *third*, for two of the above reasons, and because 5027 is not in issue in this cause for comparison or otherwise. The fourth and fifth paragraphs state a defense sufficient in law, if true, to bar a recovery, and we therefore replied to the plea. The fifth paragraph sets up new affirmative matter of de-

fense, the truth of which was put in issue by the replication, and no evidence was offered in support of it. Whether the claim of reissue 5027 was expanded or not is irrelevant, as that patent is not in issue, and the comparison is not made with it.

II.

The Invention and the State of the Art.

5. The identity of the invention set forth in the original and reissued patents is a matter of legal construction on a comparison of the two instruments.

6. A comparison of the two patents for the purpose of determining the question of identity of invention, requires an interpretation of the original patent in the light of the state of the art.

That part of the device described in the original patent intended to be secured by reissue 8,759, is a self-fastening metallic lining for the bung holes of casks, &c., designed to be stopped with a wooden or compressible bung.

It has been called a "metallic screw-threaded bung *bush*," but it has nothing in common with the ordinary bush of mechanics, and is simply a metal lining for the bung hole of a barrel. It is made as thin and light as the strength of metal and use will permit; smooth and tapering inside, to permit the insertion of, and to compress and hold a wooden bung; and tapering outside to enable the lining to be readily inserted in the bung hole of the barrel; and provided with a screw-thread on the outside, which draws the lining into place and fastens it there, and so imbeds itself in, and compresses the fibers of the wood around the bung hole, as to render the metal substantially integral with the wood, and secure an absolutely tight joint between the wood and the metal, sure

to be maintained under all circumstances, by the expansive force of the wood compressed by the taper of the lining, and between its threads in screwing it in. The bung hole of the barrel, as thus lined, is stopped when the barrel is in use by a compressible bung, usually made of wood, which is driven into the aperture until the bung hole is tightly closed. This lining is provided with a rim or flange at the larger end, designed to rest on the outside of the stave to strengthen and finish the device.

In the case of fermenting liquids it is essential to the preservation of the contents of the barrel, that the bung-hole shall be stopped so tightly as to prevent the escape of the gases generated in the barrel during the process of fermentation. If they escape the contents of the barrel are spoiled.

The importance will, therefore, at once be perceived of having a round, smooth surface for the interior of the bung-hole, adapted to receive, compress and hold the round wooden bungs, which are prepared for use and sold by the barrel, or other large quantity, to brewers and the trade.

Before the invention of the metallic lining, the interior surface of the bung-hole was rough and uneven on account of the impossibility of cutting a smooth and round hole through the hard-grained, oak wood, mostly used for staves. So that in new casks it was difficult to tightly stop the bung-hole, the difficulty increasing with use, and if the hole was made tapering the bung operated as a wedge and was liable to split the stave.

These beer barrels and kegs in practical use are filled, emptied and re-filled several times during each year; and each time the abrasion of inserting and removing the bung, and of the tools and implements used in doing it, and of the tools and implements used in washing and

pitching the interior of the barrel or keg, rendered the interior surface of the bung-hole more broken and uneven, until it finally became incapable of being tightly stopped; the result being the loss of the contents of the barrel or keg, and the requirement that the barrel or keg be sent to the cooper-shop to have a new bung-stave inserted, which required a new pitching, besides the loss of the use of the package while in the shop for repairs.

The want of a means for protecting brewers from loss in this way had long been felt, and much effort had been expended to accomplish that result, as is demonstrated by the number of citations made by the examiner in the patent office, in the consideration of the application for reissue 8,759. (Rec., 5, 30.) But the line of experiments had been mainly in the direction of *metal bungs*, for which several patents had been taken out, all of which had failed of adoption by the public, because impracticable. Most of the citations were metal bungs having an outside case screwed into the stave in which the metal bung was fastened by means of slots, annular recesses, or inwardly projecting lips, formed on or in the interior side of the case which rendered their use with a wooden bung impossible. Only one metallic lining for a bung-hole had been devised previous to the invention of Cornell & Lacey, to be used with a wooden bung—that of Kenyon & Menzies in 1863, which was nailed to the stave, was only used experimentally, proved a failure and went out of use—became simply an abandoned experiment.

Such was the state of the art when Cornell & Lacey, in the spring or summer of 1866, (Rec., . 26) invented the screw-threaded metal lining which is the subject of this litigation. Prior to that time no form of metal lining for bung-holes had been successfully reduced to practice. (Rec., 3.)

In the state of the art in regard to the practical protection of bung holes, the exact, but not unusual state of facts mentioned by Judge Shepley, in *Hike* v. *Railroad Co.*, 6 Off. Gaz., 576, existed. In that case after suggesting that the devices nearest to the patented device had some features in common therewith, but "differed from it in precisely those particulars which distinguish an incomplete and practically unsuccessful attempt from a perfected invention," he says: – "This is the history of the art in relation to most of the important discoveries and inventions of the present day. The want, which the discovery or invention is to supply is first felt, and the genius of invention is aroused, and the thoughts and efforts of inventors are directed in a particular channel. When one achieves success, it not infrequently appears that prior inventors have been travelling in the same path, and in the light of his success, we look back with wonder at the omission of those who started earlier in the race to take the last short step, which separated them from the goal. But it is the last step in the race of discovery or invention that counts, and he who first crosses the dividing line between experiment and success wins the prize over those who, having started earlier in the race, are but a single step behind at the goal."

Cornell & Lacey took the last step and won the goal in the matter of this device. They produced a satisfactory and practical lining for the bung holes of barrels, which has been accepted as the ultimate of invention for that purpose; one which is in use by nearly every brewer in the United States, and is and has been, the only one used and in use for a period of over sixteen years, or since it was introduced by the complainant to the public in 1869–70. It is estimated that more than six millions of these linings have been sold and used, and that nearly three million dollars have been saved thereby to the pro-

ductive industry of the country. There cannot be any more conclusive evidence of novelty than universal adoption maintained without change for a series of years.

It is evident that this device when inserted becomes in effect an integral part of the bung-stave, absolutely protecting it from danger of being split in driving home the wedging bung. It also furnishes a bung-hole, arranged to receive and hold a wooden bung, absolutely free from danger of injury by the tools used in inserting and removing the bung, or by the heat necessarily used in pitching the inside of the barrel, or the use of pitching tools, or otherwise by abrasion, thus supplying all and the exact requirements of a bung-lining.

COMPARISON OF THE PATENTS.

Re-issue 8,759 is not for all the inventions shown in the original patent. We do not understand this to constitute an objection to it. *Albright* v. *Cell. H. T. Co.*, 12 O. G., 228. Two disconnected and independent devices are shown, described and claimed as the invention of that patent, namely, 1st, "An improvement in Metallic Bushings for the Bungs of Casks, &c." and 2nd, "An improvement in wrenches for operating bushings for bungs." One of these devices could be used without the other. The wrench had no connection with the functions of the bush. Other means were known for inserting the bush, and when inserted by other means the wrench had no function in connection with it. The wrench does not at any time operate *with* the bush, it operates *on* it when used to insert it, the same in effect as a hammer operates on a nail. As said by the Commissioners of Patents:—(Rec., 22). "There is no combination of this bush with that wrench, any more than with any other wrench." These two devices were found by the patent office to be the invention of the patentee and a single patent was granted for them as a combination. It is true the claim

was defective, otherwise, in that it contained unnecessary details of construction both of the wrench and bush, but it was regarded by the patentee as invalid, because it was for a combination that did not exist—an attempt to patent two inventions with separate uses in one patent. It was evident that either device could be used without the other, and that when so used neither was protected by the patent.

It was to protect these inventions in the separate uses to which they were adapted, and not to cure minor defects of a restrictive character, then unthought of, that the first reissues were applied for and allowed. And thus it happened that in the claim of reissue 5,027, the details of the claim of the original patent were retained to the largest extent consistent with the purpose to claim the bush invention separately. It was not at that time or for years afterwards believed by the patentee that any further modification was required to secure his invention to him. Thus it happened that the claim of reissue 5,027 contained the clause, "provided with the flange B, having the V-shaped notch *d*," and that it again became necessary to reissue this patent, for the purpose of leaving the notch out of the claim, in order to cover the invention. There is, so far as we are aware, no pretence that the bush shown, described and claimed in the original patent, and the bush shown, described and claimed in reissue 8,759, are not the same except for the failure to claim the notch as a feature of the bush in the reissue.

III.

7. The notch in the flange was not a essential feature of the bush invention, but could be left out and the essential characteristics of the invention remain unaltered.

The specification of 118,617, says, "we have invented a new and valuable improvement in metallic bushings for the bungs of casks, etc.," and "our invention has relation to means for protecting the bungs of casks, etc., and consists in an improvement in metallic bushings for lining the bungs, which is cast with a screw thread," and that it consists of "a tapering thimble or ring of metal provided with a flanch, *b*, at its larger end and having a screw thread *c* on its outer surface."

A reference to the drawings of the original patent and re-issue 8,759 will show that the above is a full and correct description of the bush or lining described and claimed in re-issue 8,759, except that the re-issue is largely restricted by the disclaimer introduced into it, and by the specific terms of the claim.

In the original patent it is further stated that "the flanch *b* is rounded off at its edge; and is provided at some point in its extent with a V-shaped notch *d* extending in to the screw-thread." No function is attributed to the V-shaped notch in connection with the use of the device as a bush or lining. But a wrench to screw this bush or lining in with is also described, and in connection with the description of this wrench, it is stated that "the wrench is applied by inserting the core into the opening through the bushing and turning it until the projection *l* falls into the notch *d*." From this it is evident that the notch did not relate to the bush invention, but was merely incidental to its use with this special form of wrench described in the patent, and made to operate on the bush in the act of inserting it.

It is also evident that neither the rounding off of the flange, nor the insertion of the notch in it can have any effect upon its use or usefulness as a lining to a bung hole. The only intimation in the entire patent that the notch has any use is in the statement of the method of applying the wrench in screwing the bush in. This demonstrates, so far as inference can demonstrate, that its only use was in connection with the specific wrench described; and to enable the application of that particular wrench to the purpose for which said wrench was designed.

There is no mistaking this matter. The bush is described in the original patent as a "metallic bushing for lining the bungs." The invention of that device had nothing to do with the means of screwing it in. That related to the wrench, and is so stated in the patent. The bush was necessarily invented first, and it would require a violent stretch of imagination to believe that it had a notch in the flange before that was filed in to enable this wrench to be attached to it. Now it seems to us axiomatic, that the inclusion in the specification and claim of a patent, of the description of a thing as an element or feature of the invention, not necessary for, or participating in the accomplishment of the purpose for which the invention was designed and is used, does not make the thing so described and claimed a part of the invention. It may render the patent inoperative as the original patent in *Morey* v. *Lockwood*, 8 Wall., 230, but it does not change the actual invention. The invention consists of the means required to produce the desired result; whatever else is described and claimed in the patent is *dehors* the invention. In this case the "tapering thimble or ring of metal provided with a flange at its larger end, and having a screw-thread on its outer surface" was all the means required to line and protect the bung holes of casks, etc., the desired result, and was the invention, and all of the invention, relating to the bush shown in the

original patent. The result sought in this case was "means for protecting the bungs of casks," and to accomplish it "a tapering thimble or ring of metal" was made to be inserted in the inside of the bung hole. The flange had a function in connection with the adjustment of this thimble, to prevent it from being screwed in too far, but it goes without argument that the shape of the outer edge of the flange and the notch in it had nothing to do with the use of the device as a bung lining.

What possible difference could it make whether it was rounded off at the edge or square?—or whether it was smooth, notched or serrated? - or whether it was round, square or octagonal? Either form would not make the screw-threaded metallic thimble of any greater or less use as a protection to the inside of the bung hole. It was probably considerations of this kind that influenced the Commissioner of Patents to refuse to allow a specific claim for the bush with a notch in the flange in re-issue 8,759 (Rec., 21.) At any rate he did refuse it, and of course thereby declared that in the judgment of the patent office it was not part of the bush invention.

If screw threaded metallic bung hole linings had been old or known to the public when Cornell & Lacey made this bush invention, and their invention had been something that made this screw threaded metal lining cheaper or more useful, and that something had been a notch in the flange, and the notch in the flange had been patentably new, that bush, with the notch in the flange, would have been patentable as an improved lining, and the notch would have constituted the whole invention; and if in that case they had reissued and left the notch out, the reissue would not be for the same invention, because it would then be for the lining with their improvement left out; that is, the invention they made. But in this case it is conclusively established, not only that Cornell & Lacey

were the first to produce the screw threaded metallic bung lining, but that no form of bung lining had been successfully reduced to practice, until that result was accomplished by them, (Rec., 3.) and that the public is entirely indebted to them for this useful and valuable device. They did not invent a special form of screw threaded metallic bung hole lining, but the WHOLE THING—the screw threaded metallic bung hole lining itself —therefore their invention was the whole thing and they were clearly entitled to reissue to cover their invention. If it became necessary to leave out from the claim a restrictive detail like the notch in the original claim, it was their right to do so, and the doing of it did not make the re-issue for any different invention from that of the original.

We think the foregoing considerations establish, (1) that the bush invention was complete without the notch; (2) that the notch was not a part of the bush invention; (3) that the invention was the bush with or without the notch; (4) that the claims of the original patent and re-issue 5,027, covered only the bush with the notch, and did not cover the bush without the notch; (5) that in failing to cover the bush with or without the notch, these patents failed to cover the patentee's actual invention; (6) that re-issue 8,759 covers what the inventors honestly invented and nothing more.

IV.

WAS THERE LACHES?

8. *Under the circumstances shown in this case there was no unjustifiable delay in applying for re-issue 8759.*

If there was delay in taking this re-issue no adverse rights intervened. So far as known, no one has claimed that a bush without a notch was a patentable invention as against a prior patented bush with a notch.

At any rate no patent has been granted for such an improvement. The public had acquiesced in the patentee's claim that his patent covered the bush with or without the notch in the flange. (Rec., p. 5.) And the defendant in this case did not commence making bushes without a notch, and did not go in the bush business until after re-issue 8759, was allowed. (Rec. 7.) The patentee has always claimed that his patents covered bushes with or without the notch, and evinced his faith in this claim by bringing suits against infringers for using bushes without the notch, in which he was sustained by repeated decisions of the U. S. Circuit Court. (Rec., 4, 5.) The public acquiesced in that construction of his patent, until the decision of the Schumacher case, in 1878, when he, without loss of time, applied for a re-issue. Up to that time, he had a well founded belief that his patent covered the metallic screw threaded bung-lining with or without the notch. He then first had reason to believe that his patent was so restricted by the faulty claim of the notch in the flange as to be inoperative to secure all that he was by his specifications entitled to claim, which under *Powder Co.* v. *Powder Co.*, 19 Fed. R., 509, authorizes a reissue and is wholly outside of any of the restrictions stated in *Mahn* v. *Harwood*, 5 S. C. R., 174. Achison J., in *Stutz* v. *Armstrong*, 20 Fed. R., 843, says:—

"The Supreme Court has laid down no unbending rule by which to determine what is unreasonable delay in applying for the correction of such a mistake as existed here; and it seems to me that each case must be decided upon its special facts and merits."

And Sawyer, J., in *Powder Co.* v. *Powder Co.*, *supra*, says: —

"When courts make a mistake, it may, very properly, be conceded that a patentee may well make an honest mistake himself."

Justice Gray, in Gage *v.* Herring, 2 Sup. Ct. Rep. 825, says:—

"Considering that the question of the validity of the new claim in the re-issue, is a question of law upon the face of the patent, and that its validity has been sanctioned by the Commisioner of Patents in granting the re-issue, and upheld by the Circuit Court, there has been no unreasonable delay in entering a disclaimer; for *the plaintiffs were not bound to disclaim until after a judgment of this court upon the question*."

The same principle applies to applications for re-issues.

Judge Sage, in *Odell* v. *Stout*, 22 Fed. R., 163, says:

"There is a suggestion in *Miller* v. *Brass Co.*, of two years as the limit to the delay permissible, with reference, by way of analogy, to the evidence of abandoment afforded by the inventor's consent to the public use of his invention for that length of time before his application for a patent; but there is no rule fixing a precise limit of time. The rule relating to time is statutory, and therefore rigid, and to be applied according to its letter. The rule relating to re-issues is equitable, and therefore flexible, and to be applied according to equity. What is a reasonable time is a question, when a re-issue is attacked, to be decided by the court upon the case presented; and, as we understand it, the Supreme Court has purposely avoided prescribing any rule which would interfere with the decision of each case upon the equities arising upon the facts of that case."

This court has never required patentees to be wiser than Circuit Courts; it has always allowed them to rest upon the construction given to patents by the Circuit Court Judges; and in this case the patentee was justified in relying upon the construction given 5,027 in the Circuit Court, until that construction was changed, modified, or reversed by this court. That happened in the decision of the case of *Schumaker* v. *Cornell* by this court upon a cognate invention covering by analogy the construction of the claim of the bush patent, and when this court by

its decision in that case intimated that the notch was an element of the claim of the bush, the limitation of which could not be constructively disregarded, the patentee immediately made application for, and in due time was granted re-issue 8,759. He applied for it because re-issue 5,027 was inoperative to protect his actual invention, made so by the improper inclusion of the notch, which had not then been used by him or others for years, and which he himself was the first to demonstrate could be omitted in practice without interfering in the least with the beneficial use of the patented invention. Here apparently was all the diligence shown that ever has been or ever can be properly required.

V.

9. The patentee had a right to broaden the claim of the original on the re-issue to cover the actual invention.

There having been no unjustifiable delay in applying for the re-issue, the patentee had a right to cover the original invention in the re-issue 8,759. If to do so required the claim to be made narrower, he would have been compelled to make it narrower; as it was required to be broader he had the right to make it broader. The doctrine of re-issue with its limitations is well stated in *Odell* v. *Stout*, 22 Fed. R., 162-3, where the court say:

"The inventor is entitled also to a patent for his entire invention. He cannot, as Mr. Justice Bradley says in *James* v. *Campbell*, 104 U. S., 378, 'take a re-issue for anything but the same invention described and claimed in the original patent.' It is to be kept in mind, however, that enlarging the claim may be an entirely different thing from broadening the invention. He may, under proper circumstances, so enlarge his claim as to make it extend to the limits of his invention, but he is bound by

those limits. He may not enlarge the invention. * * * *Miller* v. *Brass Co.*, 104 U. S., 350, and *James* v. *Campbell*, *id.*, 370, do not sustain the proposition made on behalf of the defendants, that a re-issued patent is void if the claims of the original patent are expanded. These cases, and others of later date, distinctly recognize that the claims of an original patent may be enlarged, by re-issued letters, to include the entire invention, or, in separate claims the distinct patentable features of the invention; provided, *First*, that there be no unreasonable delay in applying for the re-issue; and *Second*, that between the date of the original patent and the date of the application for the re-issue, rights which would be recognized in equity in favor of others shall not have intervened."

In *Miller* v. *Brass Co.*, this court say:—"The great object of the law of re-issue seems to have been to enable a patentee to make the description of his invention more plain and specific." And: "we do not deny that a claim may be enlarged in a re-issued patent." And further; "Re-issues for the enlargement of claims should be the exception and not the rule, and where if a claim is too narrow—that is, does not contain all that the patentee is entitled to."

In *James* v. *Campbell*, 14 Otto, 356, the court say: "When a patent fully and clearly without ambiguity or obscurity describes and claims a specific invention, complete in itself, so that it cannot be said to be inoperative or invalid by reason of a defective or insufficient specification, a re-issue cannot be had for the purpose of expanding and generalizing the claim so as to make it embrace an invention not described and specified in the original." Of course the converse is true that when a patent is invalid or inoperative by reason of a defective specification an expansion of the claim can be allowed and sustained.

In the *Driven Well Cases*, 7 S. C. R., 1081, the court say: "If the amended specification does not enlarge the scope of the patent by extending the claim so as to cover more than was embraced in the original, the rights of

the public are not thereby narrowed, and the case is within the remedy intended by the statute. Those cases in which this court has held re-issues to be invalid were of a different character, and were cases where by the re-issued patent *the scope of the original was so enlarged as to cover and claim a new invention*, that which was either not in the original specification as part of the invention described, or, if described, was, by not being claimed, virtually abandoned and dedicated to the public use. Here the amended specification does not enlarge the scope of the original invention as described in the original specification. It simply in this respect supplies a deficiency, by describing with more particularity and exactness, the means to be employed to produce the desired result."

In *Parker & Whipple Co.* v. *Yale Lock Co.*, 41 O. G., 813, in considering what may be included in the reissue that "was suggested or indicated in the original specification, drawings or Patent Office model" this court say:

"The things so to be included are only the things which properly belonged to the invention as embodied in the original patent; that what that invention was is to be ascertained by consulting the original patent, and that, while the new description may properly contain things which are indicated in the original specification, drawings or Patent Office model, (though not sufficiently described in the original specification), it does not follow that what was indicated in the original specification, drawings, or Patent Office model is to be considered as part of the invention, unless the court can see from a comparison of the two patents that the original patent embodied as the invention intended to be secured by it what the claims of the reissue are intended to cover."

This seems to us an eminently proper, equitable and salutary rule of construction. In our case, "the things which properly belonged to the invention as embodied in the original patent, * * * as the invention intended to be secured by it," were the things required to constitute a screw threaded metallic bung lining, and a screw threaded metallic bung lining is precisely what the claim of the reissue is intended to cover and does cover; namely, what the original patent describes as "means for protecting the bungs of casks, &c., * * * a tapering thimble or ring of metal provided with a flange, *b*, at its larger end, and having a screw thread, *e*, on its outer surface."(Rec., p. 13). (See pages 12 to 17 of this brief).

In *Seymour* v. *Osborn*, 11 Wall., 516, the court say: "Power is unquestionably conferred upon the Commissioner to allow the specification to be amended if the patent is inoperative or invalid, and in that event to issue the patent in proper form; and he may doubtless, under that authority, allow the patentee to re-describe his invention and to include in the description and claims of the patent not only what was well described before, but whatever else was suggested or substantially indicated in the specifications or drawings which properly belonged to the invention as actually made and perfected."

In cases like this where the claim has been such that it was competent for any one to evade the patent and enjoy the substance of the invention by changes in the mere form of construction, reissues have always been sustained since the idea of a reissue was first introduced into our patent system.

Batten v. *Taggert*, 17 Howard, 74.
Morey v. *Lockwood*, 8 Wall., 230.
Rubber Co. v. *Goodyear*, 9 Wall., 788.
Brown v. *Guild*, 23 Wall., 181.
Bennett v. *Fowler*, 8 Wall., 445.
Marsh v. *Seymour*, 97 U. S., 366.

The doctrine of *Batten* v. *Taggert* is that, even if the original patent claims a combination, it may be surrendered and a re-issue taken, describing and claiming only a part of the machine described and claimed in the original patent. And the court say:—"He had a right to restrict or enlarge his claim, so as to give it validity, and to effectuate his invention."

The doctrine of *Morey* v. *Lockwood* is, that when the patent is inoperative by reason of a defective claim, it is the duty of the commissioner to correct the claim in a re-issue. That case is here largely in point. The court say:

"The amendment was very material, as the language of the original claim tied the patentees down to a syringe, *consisting of the parts mentioned* * * * * tying them down to the mere form of the construction, *regardless of the substance and legal import of the invention.* While the original specification and claim remained, it was competent for any one to evade the patent, and enjoy the substance of the improvement, by a change in the mere form of construction. * * * And this is what the defendants are endeavoring to accomplish, and would have accomplished if the amendment of the claim had not been allowed."

The *Rubber Co.* v. *Goodyear* holds that it is for the commissioner to determine whether the original patent is defective, and a reissue allowable. And that "it is the right of the patentee and his representative to enlarge or restrict the claim so as to give it validity and secure the invention."

The corn planter case of *Brown* v. *Guild*, illustrates the control the commissioner exercises over original patents in issuing re-issues, and distinctly recognizes not only the right of the patentee to take out re-issued patents for separate inventions originally claimed together, but to adapt the description and claim of the

re-issue to cover the separate invention sought to be protected.

The doctrine of *Marsh* v. *Seymour*, in brief, is, that an inoperative patent may be amended, either as to specification or claims, and issued in proper form, covering not only what was well described, but whatever was suggested in the specification and drawings.

In all these cases, and in numerous cases in the Circuit Courts, it has been held legitimate, in a re-issued patent to so modify the original specification, as to secure protection broadly to the *real invention* of the patentee against any form of infringement.

Dorcey Co. v. *Marsh*, 6 Fish., 387.
Poppenhousen v. *Falk*, 2 Fish., 213.

SCHUMAKER *v.* CORNELL.

The case of *Schumaker* v. *Cornell*, 6 Otto, 549, was decided wholly upon the question of the infringement of the defective claim of the patent for the cognate invention—the wrench. Neither the original patent 118,617, nor reissue 5027 were before the Court, and of course reissue 8759 was not. The record in that case, so far as the testimony was concerned, was demonstrated by subsequent litigation to have been imperfect and misleading as to the state of the art. The Court, as to the reissued wrench, patent 5056, expressly disclaim the consideration of the question whether or not it was for the same invention as the original patent, and say:—"This opinion will be confined to the question of infringement." They decide that the patentee "must stand by his claim as he made it," and that the device as *claimed* was not infringed. Upon the record in that case the court was constrained to say that "bushes" "are very old," which of course is true in the abstract, but as applied to this bung lining device, was a mistaken conclusion, and so proved

by the record in this case. The record in this case (Rec. 3) shows that this device "not only was not known or used prior to the invention thereof by said Lacey and your orator, but that no form of metallic lining for bung-holes had been successfully reduced to practice." There is, therefore, nothing in that case that ought to influence the Court to our prejudice in the decision of this case.

VI.

10. The Presumption of the Law is in Favor of the Identity of the Original and Re-issue.

Revised Statutes, Sec. 4916, provides that whenever any patent is inoperative by reason of a defective specification, if the error has arisen by inadvertence, accident or mistake, and without fraudulent intent, the Commissioner of patents shall, on the surrender of such patent, cause a new Patent for the same invention, with corrected specifications, to be issued for the unexpired term of the original patent. That the Commissioner may cause several patents to issue for distinct parts of the thing patented, and that the specification and claim shall be subject to revision and restriction, the same as original applications are.

It is well settled that when the Commissioner accepts a surrender of an original patent and grants a new patent, his decision in the premises in a suit for infringement is final and conclusive as to the existence and sufficiency of the cause for reissue, as to the number of patents to be granted, and as to the restrictions and limitations to be imposed upon the re-issues.

The action of the commissioner establishes *prima facie* that the reissue is for the same invention as the original, and is conclusive upon that point unless there is such a repugnancy between the old and the new patent

that it must be held as matter of construction, that the new patent is not for the same invention embraced in the original. The presumptions of the law are conclusive in this case because there is no repugnancy whatever between the old and the new patent. The device shown in the original, was a screw threaded metallic bung lining, and in the re-issue the same screw threaded metallic bung lining. There is neither repugnancy nor room for construction.

In the exercise of his discertion to revise and restrict the terms of the specification in the re-issue, which is as broad as in the case of an original application the commissioner refused to allow a claim in the re-issue application for the notch in the flange upon the ground that it was not novel or patentable as part of the bush invention. (Rec., 21 and 23). Under what law does the Circuit Court of the Eastern District of Michigan, re-examine this exercise of discretionary authority vested in the Commissioner of Patents? That most eminent jurist, Judge Story, in the case of *Carver* v. *Braintree M'f'g. Co.*, 2 Story, 439, asks the question:—"How can the court in this case judicially know * * * that the Commissioner did not positively require this very omission?" And he regarded the bare suggestion that the Commissioner *might* have required the omission, as a sufficent answer to the objection that much more material parts of the device claimed in the original was left out of the reissue claim, and says further:—"I see nothing" in the provisions of the patent law, "which requires the patentee to claim all things in the renewed patent, which were claimed as his original invention, or part of his invention in his original patent." In this case the record establishes that the Commissioner did require the omission of the notch in the flange from the claim of reissue 8,759. (Rec., 21 and 23). And this action of the

Commissioner it seems to us conclusively establishes that the notch was not a part of the invention of the bush device.

The omission of the notch from the claim of the re-issue is alleged to expand it, in other words, to make the re-issue cover more than the original claim. Suppose it does have that effect? What else is the purpose of a reissue? To authorize a re-issue the patent must be inoperative or invalid in whole or in part, for the reason that it claims too much or too little, and to just the extent that the re-issue law is answered, and the defective patent becomes operative or valid, to just that extent the reissue is made to cover more or less than the original. The design of the reissue law is to cover just such a case as this. Its intent is to secure his invention to the inventor. If he has failed through inadvertence, accident or mistake, and without fraudulent intent, to cover his invention in his original patent, he is permitted to re-issue and modify his specification and claims so as to cover it, whether the modifications result in broadening or narrowing the claims. And as to the question of inadvertence, accident or mistake, and good faith, the decision of the Commissioner has never been held otherwise than conclusive in a case like this.

Conclusion.

Of all the defenses ever set up to this patent, the defense that the reissue 8,759 is not for the same invention as the original patent has the least foundation in law or fact.

The original patent, it will be recollected, describes the device as, "a tapering thimble or ring of metal provided with a flanch, *b*, at its larger end, and having a screw thread on its outer surface." This, with the reference to the drawing, makes a very exact description of

the device heretofore, and now made and used. The specification in reissue 8,759 is as exact and specific a description of the same device as the language is capable of.

The claim in the reissue is modified, but it exactly describes the identical thing shown and described in the original. If it be held that the notch in the flange is part of the description of the device described in the original patent, and is left out of the description in the reissue, that does not make the reissue any less for the same invention, because the prohibition of the act is against the adding of new matter, and there is no obligation resting upon the patentee to claim in a reissue all things which were claimed in the original patent.

Carver v. *Braintree M'f'g. Co.*, 2 Story, 438.
Albright v. *Harness T. Co.*, 12 O. G., 228.
Fruit House Co. v. *Busch*, 2 Biss., 472.

We therefore insist that the defence made by the plea is not sustained; that the finding of the Circuit Court was erroneous and productive of great wrong and injustice to the complainant; and that the decision of the Circuit Court should be reversed and the cause remanded.

Respectfully submitted,

J. W. MERRIAM,
Solicitor for Cornell.

JOHN H. WHIPPLE,
of Counsel.

7-261

Office Supreme Court U. S.
FILED
APR 13 1888
JAMES H. McKENNEY
Clerk

Supreme Court of the United States.

OCTOBER TERM, 1887.

No. 240.

GEORGE B. CORNELL, APPELLANT,

vs.

PAUL WEIDNER, APPELLEE.

BRIEF FOR APPELLEE.

GEO. H. LOTHROP,
Counsel for Appellee.

DETROIT:
John F. Eby & Co., Printers, 65 & 67 West Congress St.
1888.

Supreme Court of the United States.

OCTOBER TERM, 1887.

GEORGE B. CORNELL,
Appellant,
vs.
PAUL WEIDNER.

BRIEF FOR APPELLEE.

STATEMENT OF THE CASE.

In 1884 appellant filed his bill in equity in the Circuit Court of the United States for the Eastern District of Michigan, alleging infringement of re-issued patent No. 8759, dated June 17th, 1879.

To this bill appellee pleaded invalidity of the re-issue, because for a different invention from the original, and because issued in violation of the statute, annexing a copy of the original patent and both re-issues to his plea.

Appellant filed a general replication.

The plea was argued before the district judge, who expressed the opinion that the re-issued patent was bad, but formally overruled the plea, and subsequently ordered a re-argument before a full bench.

This was had March 25, 1885, when the plea was sustained and the bill dismissed.

The finding of the court that the patent sued on is "not "for the same invention as the original of said re-issued "letters patent, and is void," will undoubtedly be the error assigned.

Appellee offered no evidence beyond the patents in support of his plea, deeming the identity of the invention covered by the original and re-issue a matter to be determined by comparison.

Ball vs. Langles, 102 U. S., 130.

Appellant offered in evidence the file wrapper and contents of the re-issue application, which is printed in the record, and also took some depositions, which he has not printed.

Appellee's Points.

1. The re-issue is for a different invention from the original patent and first re-issue.

2. The original patent and first re-issue covered the whole invention disclosed by the specifications of those patents, and were not inoperative or invalid; therefore the Commissioner of Patents had no authority to grant the last re-issue.

3. If the specifications of the original and first re-issue were defective or insufficient, they were so because of an error in judgment in describing and pointing out the invention, and this cannot be cured by re-issue.

These propositions are founded on:

Powder Co. vs. Powder Works, 98 U. S., 138.
Mnfg. Co. vs. Ladd, 102 U. S., 412.
Johnson vs. R. R. Co., 105 U. S., 539.
Coon vs. Wilson, 113 U. S., 277.

4. There is no valid excuse shown for the long delay in applying for this re-issue, and this delay is fatal.

Miller vs. Brass Co., 104 U. S., 350.
Mahn vs. Harwood, 112 U. S., 354.

The first three points involve an examination and comparison of the original patent and two re-issues, and will be considered together.

The original patent was granted August 29, 1871, No. 118617.

Its title is: "Improvement in Combined Bushes and Wrenches for Bungs."

It was for a bushing and a wrench, and described the bushing as follows: "*a* of the drawing designates the bushing—a tapering thimble or ring of metal, provided with a flanch, *b*, at its larger end, and having a screw-thread, *c*, on its outer surface, which screw-thread is cast on the bushing in the mold, and is capable of immediate use without other finishing. The flanch *b* is rounded off at its edge, and is provided at some point in its extent with a V-shaped notch, *d*, extending into the screw-thread."

The wrench is described as having a core to fit in the bushing and a V-shaped projection to engage with the notch. The operation of the wrench is thus described: "The wrench is applied by inserting the core into the opening through the bushing, and turning it until the projection *l* falls into the notch *d*. By means of the core the bushing is kept steady and is readily prevented from assuming an oblique position in the bung opening; at the same time the operator is enabled to get a better hold on the bushing than by means of the wrenches in common use, which are apt to slip from their seats when used on such difficult work as turning a rough-cast screw into place."

The claim is:

"The combination, with the notched bung-bushing *a* of

the wrench, consisting of the bar E having the slotted plate *e* and angular projection *l* and the removable core F, substantially as specified."

On August 6, 1872, this patent was re-issued in two divisions, No. 5026 being for the wrench, and No. 5027 for the bushing.

No. 5026 is not in the record, but was before this court in

Schumacher vs. Cornell, 96 U. S., 555.

In No. 5027 the invention is described as follows:

"In the drawing A represents the bushing proper, which consists of an annular ring of metal. This ring is made tapering on both its outer and inner sides, as shown in Fig. 2, and is screw-threaded upon its outer side, by which means the same is secured within the aperture in the cask. This thread may be formed by a suitable tool, or may be formed in the mold, as found most advantageous. The larger end of the said ring is provided with a flange B, the outer surface or periphery of which is made in an ovolo shape, and is provided with a V-shaped notch *d*, which extends inward to a point near the body of the ring, as shown in Fig. 1. The object of this notch is to allow a suitable wrench, adapted for the purpose, to engage therewith; whereby the said bushing may be turned into place without the wrench slipping from its seat, as would be the case with a bushing having a smooth surface."

The claim is: "The screw-threaded metallic bung-bushing, made tapering upon both its outer and inner sides, and provided with the flange B having the V-shaped notch *d*, as and for the purpose described."

Down to November 3, 1878, the patentees seem to have been contented with the re-issue 5027, and at that time they filed the application for the re-issue now in suit.

This re-issue is printed on pages 15 and 16 of the record.

The drawings of this re-issue show the bushing substan-

tially as shown in the drawings of the original and first re-issue, the notch being in the flange, but the notch is not mentioned either in the specification or in the claim.

The description of the bushing is as follows:

"Our invention relates to bushings for barrels, and consists of a short metallic tube in exterior form in shape of the frustum of a cone, slightly tapering. The outer surface is screw-threaded, to adapt it to be screwed forcibly into the bung-hole of the barrel, and to be held securely in place by the contact of the surfaces. The larger end of this tube is provided with an annular flange projecting outwardly, and adapted to rest, when the bushing is screwed to its place in the hole of the barrel, snugly upon the outer surface of the stave. The interior surface of the bushing is also made in the form of a frustum of a cone, and tapers uniformly from the exterior or flanged to the inner end of the bushing."

There is but a single claim, which is:

"A metallic bushing for the bung-holes of barrels, made "with a flange adapted to rest on the outer surface of the "stave, and with an exterior threaded and an interior "smooth surface, both tapering from the flanged to the "interior end, said inner surface being unbroken and unob-"structed, and tapering uniformly from one end of the "bushing to the other, as and for the purpose set forth."

In neither the original nor the first re-issue is there any hint that a tapering bushing, screw-threaded externally and smooth internally, was new, or was the thing invented by the patentees.

On the contrary, the original patent plainly intimates that screw-threaded bushings were old.

The problem which Lacy & Cornell were working upon, as disclosed by these patents, was a means of inserting a screw-threaded bushing into a bung-hole, and nothing

beyond this was in their minds, or in the mind of the man who drew the patent.

It is evident from the sentence in 5027, beginning. "The object of this notch," that the patentees deemed it impossible to insert a bushing which had no special provision for engagement with a wrench.

The invention of the original patent is therefore the notched bushing and the V-projection wrench, and the invention of re-issue 5027 is simply the notched bushing.

In the claim of the original and first re-issue a V-shaped notch in the flange of the bushing is a material element. No bushing which entirely omits this notch can possibly infringe these claims.

In speaking of re-issue No. 5026, and showing the importance of the notch in the bushing and the V-shaped projection on the wrench to the scheme of invention, this court said: "They are, therefore, vital in the invention covered by his patent. The notch is the point of engagement between the bushing and the wrench when the latter, operating as a lever, gives the former its circular motion and thus forces it home. Without this arrangement such motion could not be communicated and the desired result produced. Hence its importance in the scheme of the invention. Without it the rest would be as worthless for the end in view as one blade of a pair of scissors disjointed from the other."

Schumacher vs. Cornell, 96 U. S., 555.

The invention of the re-issue No. 8759 is a different thing.

The bushing therein described has no notch in the flange. True, the notch is shown in the drawings, but the specification is utterly silent on that point, and the claim is carefully worded to exclude the notch as an element. This claim is entirely satisfied by a bushing without the notch.

Therefore the thing which in the original and first re-issue

was of vital importance to the invention, and which was a specific element of the claim in both, has entirely disappeared.

It is axiomatic that two things cannot be the same when the distinguishing characteristic of one is utterly wanting in the other.

The first re-issue, No. 5027, fully and completely covered the invention therein disclosed, and was not inoperative or invalid, so as to bring this patent within the statute authorizing a re-issue.

In the original patent there is no hint that the invention, so far as the bushing is concerned, extended any further than the notch in the flange. The notched flange, its object, and the advantages which this form of construction afforded in connection with the patentees' wrench, are fully and completely set forth. Indeed the patentees point out that other wrenches, on other bushings, are apt to slip from their seats.

After holding the original patent for about a year, and examining it with sufficient care to discover that it was not what they wanted, the patentees applied for a re-issue. Surely they must by that time have discovered that the patent did not fully cover the bushing which they had really invented, if such was the case. But they took a re-issue in which the bushing was described substantially as before, and in which the claim was still limited by the notch in the flange. And they make more emphatic the statement in the original patent, and say that by means of the notch the wrench will be kept from slipping from its seat, "as would be the case with a bushing having a smooth surface."

Men who had invented a bushing without a notch in the flange, and who thought it valuable enough to take a patent for it, would never have used this language.